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No. 01-

IN THE

Supreme Court of the United States

ERIC ELDRED, *et al.*,

Petitioners,

v.

JOHN D. ASHCROFT, In his official capacity as Attorney General,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Did the D.C. Circuit err in holding that Congress has the power under the Copyright Clause to extend retrospectively the term of existing copyrights?

2. Is a law that extends the term of existing and future copyrights "categorically immune from challenge[] under the First Amendment"?

3. May a circuit court consider arguments raised by *amici*, different from arguments raised by a party, on a claim properly raised by a party?

PARTIES TO THE PROCEEDINGS AND CORPORATE DISCLOSURE STATEMENT

The parties to the proceedings in the United States Court of Appeals for the District of Columbia Circuit were petitioners Eric Eldred, Eldritch Press, Higginson Book Company, Jill A. Crandall, Tri-Horn International, Luck's Music Library, Inc., Edwin F. Kalmus & Co., Inc., American Film Heritage Association, Moviecraft, Inc., Dover Publications, Inc., and Copyright's Commons, and Janet Reno in her official capacity as Attorney General of the United States and her successor, John D. Ashcroft. None of these parties is either publicly held or affiliated with an entity that is so held. The Eagle Forum Education and Legal Defense Fund, L. Ray Patterson, Laura N. Gasaway, and Edward Walterscheid, as well as the Sherwood Anderson Literary Estate Trust, Sherwood Anderson Foundation, the American Society of Composers, Authors, and Publishers, AmSong, Inc., the Association of American Publishers, Inc., Broadcast Music, Inc., the Motion Picture Association of America, the National Music Publishers' Association, Inc., the Recording Industry Association of America, Inc., and the Songwriters Guild of America appeared as *amici curiae* in the Court of Appeals.

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Consumers Union of United States v. New Regina Corp., 664 F. Supp. 753 (S.D.N.Y. 1987) 20
Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Poster., Inc., 600 F.2d 1184 (5th Cir. 1979) 20
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Georgia Television Co. v. TV News Clips of Atlanta, 718 F. Supp 939 (N.D. Ga. 1989) 21
Graham v. John Deere Co., 383 U.S. 1 (1966) 8, 12, 13

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Turner Broad. Sys. v. FCC, 520 U.S. 180 (1997) 18
Twin Peaks Prod., Inc. v. Publ'ns Int'l, Ltd., 996 F.2d 1366 (2d Cir. 1993) 20

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United States v. Lopez, 514 U.S. 549 (1995) 5, 7, 14
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United Video v. FCC, 890 F.2d 1173 (D.C. Cir. 1989) 20
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Wainwright Sec. Inc. v. Wall Street Transcript Co., 558 F.2d 91 (2d Cir. 1977) 20
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Wheaton v. Peters, 33 U.S. (8 Peters) 591 (1834) 11
Wojnarowicz v. American Family Ass'n, 745 F. Supp. 130 (S.D.N.Y. 1990) 20
Worldwide Church of God v. Philadelphia Church of God, 227 F.3d 1110 (9th Cir. 2000) 19

Statutes and Congressional Materials

U.S. Const., art. I, § 8 ..... 1, 2, 10
U.S. Const., amend I 1
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Pub. L. No. 90-416, 82 Stat. 397 (1968) 2
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Pub. L. No. 94-553, § 304, 90 Stat. 2572 (1976) 2, 3
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Satellite Home Viewer Improvement Act of 1999, Pub. L. No. 106-133, § 1001 *et seq.*, 113 Stat. 1537 (West Supp. 2001) 22
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Uruguay Round Agreements Act, Pub. L. No. 103-465 12

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Yochai Benkler, *Constitutional Bounds of Database Protection*, 15 Berkeley L. & Tech. J. 535 (2000) 17
Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 Harv. L. Rev. 281 (1970) 6
Jane C. Ginsburg, *Copyright Legislation for the "Digital Millennium,"* 23 Colum.-VLA J.L. & Arts 137 (1999) 6
Paul J. Heald and Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. Ill. L. Rev. 1119 (2000) 9, 17

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Melville B. Nimmer, *Does Copyright Abridge The First Amendment Guarantees of Free Speech And Press?*, 17 UCLA L. Rev. 1180 (1970) 21
Statement of Professor Peter Jaszi, *The Copyright Term Extension Act of 1995: Hearings on S.483 Before the Senate Judiciary Comm.*, 104th Cong (1995), *available at* 1995 WL 1052-4355 9
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Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 Stan. L. Rev. 1 (2001) 10, 18, 21, 25

PETITION FOR A WRIT OF CERTIORARI

Petitioners Eric Eldred, Eldritch Press, Higginson Book Company, Jill A. Crandall, Tri-Horn International, Luck's Music Library, Inc., Edwin F. Kalmus & Co., Inc., American Film Heritage Association, Moviecraft, Inc., Dover Publications, Inc., and Copyright's Commons respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the District of Columbia Circuit in this case.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the District of Columbia Circuit (App. 1a) is reported at 239 F.3d 372. The order denying the petition for rehearing and for rehearing en banc (App. 24a) is reported at 255 F.3d 849. The memorandum opinion of the district court (App. 34a) is reported at 74 F. Supp. 2d 1.

JURISDICTION

The judgment of the United States Court of Appeals was issued on February 16, 2001, and the petition for rehearing and for rehearing *en banc* was denied on July 13, 2001. This Court has jurisdiction over this petition under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Patent and Copyright Clause confers upon Congress the Power

> To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

U.S. Const., art. I, § 8, cl. 8.

The First Amendment provides, in pertinent part, that "Congress shall make no law . . . abridging the freedom of speech, or of the press . . . ." *Id.*, amend. I.

The pertinent provisions of the Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified at 17 U.S.C. § 304), and the other copyright laws cited in this petition are reprinted in the appendix. App. 40a - 67a.

STATEMENT OF THE CASE

This case is about the limits on Congress' Copyright Clause power. The Constitution gives Congress the power to "promote the Progress of Science" by granting "exclusive Right[s]" "to Authors" for "limited Times." U.S. Const., art. I, cl. 8. In establishing this power, the Framers intended that copyright terms be, as Justice Story described them, "short," and that after that "short interval," creative works would fall into the public domain "without restraint." Joseph Story, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES § 502, at 402 (R. Rotunda & J. Nowak eds., 1987).

Congress has now found a clever way to evade this simple constitutional command. By repeatedly extending the terms of existing copyrights—as it has eleven times in the past forty years[1]—Congress has adopted a practice that defeats the Framers' plan by creating in practice an unlimited term. These extensions were initially brief (one or two years). In 1976, the

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[1] *See* Pub. L. No. 87-668, 76 Stat. 555 (1962); Pub. L. No. 89-142, 79 Stat. 581 (1965); Pub. L. No. 90-141, 81 Stat. 464 (1967); Pub. L. No. 90-416, 82 Stat. 397 (1968); Pub. L. No. 91-147, 83 Stat. 360 (1969); Pub. L. No. 91-555, 84 Stat. 1441 (1970); Pub. L. No. 92-170, 85 Stat. 490 (1971); Pub. L. No. 92-566, 86 Stat. 1181 (1972); Pub. L. No. 93-573, Title I, § 104, 88 Stat. 1873 (1974); Pub. L. No. 94-553, § 304, 90 Stat. 2572 (1976); Pub. L. No. 105-298, § 102(b), 112 Stat. 2827 (1998). This pattern is radically different from the history of copyright during the Republic's first 150 years. In the first hundred years of copyright, Congress extended the term of copyrights once. Act of February 2, 1831, §§ 1-2, 4 Stat. 36. In the next fifty years, Congress again extended the terms only once. Act of March 4, 1909, § 4, 35 Stat. 1075, 1076. While these earlier extensions also applied to existing copyrights, the first extension in 1831 cannot be attributed to the Framers (no Framer sat in Congress in 1831), and two extensions in 150 years cannot be held to be a constitutionalized practice.

extension was nineteen years. Pub. L. No. 94-553, §304, 90 Stat. 2572. In the statute at issue in this case, the Sonny Bono Copyright Term Extension Act ("CTEA"), Pub. L. No. 105-298, 112 Stat. 2827 Congress has extended the term of existing and future copyrights by twenty years. *Id.* § 102(b).

Because of the CTEA, works originally authored in 1923 that would have fallen into the public domain in 1998 could now remain under copyright until 2019—a term of 95 years. And because of the CTEA, future copyrights will now extend for the life of the author plus 70 years (which for an author who produced in the pattern of Irving Berlin would mean a term of 140 years), or in the case of works for hire, 95 years. These terms contrast against the Framers' initial term of just 14 years, renewable once only if the author survived. Act of May 31, 1790, § 1, 1 Stat. 124.

1. Petitioners are various individuals and businesses that rely upon the public domain for their livelihood. Some, such as the lead plaintiff Eric Eldred, build free Internet libraries based upon public domain works; others, such as Dover Press, publish public domain works in high-quality commercial editions. All depend upon a rich public domain to support their work, and many make their work freely available to others.

2. In January 1999, petitioners filed a facial challenge to the CTEA, arguing (a) that its retrospective aspect (extending the terms of existing, or "subsisting," copyrights by twenty years) exceeded Congress' power under the Copyright Clause, violated the First Amendment, and violated the public trust doctrine, and (b) that its prospective aspect (extending the terms of future copyrights by twenty years) violated the First Amendment. The United States moved for judgment on the pleadings, and petitioners cross-moved for summary judgment. The District Court upheld the statute and dismissed the case. App. 34a. Petitioners appealed the rulings on its Copyright Clause and First Amendment claims.

3. The Court of Appeals, over the dissent of Judge Sentelle, affirmed the District Court's judgment. App. 1a. The court first rejected petitioners' First Amendment argument. While the court held that petitioners had standing to raise a First Amendment challenge to both the prospective and retrospective aspects of the CTEA, App. 4a, the court held the substance of petitioners' claim barred by circuit precedent and this Court's decision in *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539 (1985). App. 5a-7a. According to the circuit court, *Harper & Row* established that there is no "first amendment right to exploit the copyrighted works of others." App. 8a. By challenging a statute that extends the term of subsisting copyrights, petitioners, the court held, were "by definition" asserting a "first amendment right to exploit the copyrighted works of others." *Id.* Petitioners' claim was therefore indistinguishable from the defendant's claim in *Harper & Row*. App. 5a-8a. The circuit court thus transformed the narrow holding of *Harper & Row* into a general rule that "copyrights are categorically immune from challenges under the First Amendment." App. 6a. (interpreting D.C. Circuit authority). (The court did not explain how its reasoning would apply to petitioners' First Amendment challenge to future copyrights, which, because applying to works that have not yet been created, "by definition" cannot be the assertion of a "first amendment right to exploit the copyrighted works of others.")

The court also rejected petitioners' Copyright Clause claims. First, the court rejected petitioners' argument that extending the term of subsisting copyrights would violate the "originality" requirement of the Copyright Clause, which limits copyright to works that are "original." *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991). Though the court acknowledged that extending a copyright to a work that had fallen into the public domain would violate the "originality" requirement, App. 8a, it held that extending the terms of subsisting copyrights would not. App. 8a-9a.

Second, the court rejected petitioners' argument that the "limited Times" condition should be read in light of the

Copyright Clause's grant of power—"To promote the Progress of Science." So understood, retrospective extensions would not be "limited" in a constitutional sense. To bar retrospective extensions as unlimited in a constitutional sense. App. 10a. Instead, the court held that the grant of power "To promote the Progress of Science" does not restrict the scope of Congress' power *at all*. The circuit court therefore interpreted the "limited Times" condition independently of the requirement that Congress "promote the Progress of Science," and held that an extension (or multiple extensions) of a "limited" term was permissible so long as the extension itself was limited. App. 10a-14a.

Finally, in rejecting petitioners' Copyright Clause claim, the court refused to consider an argument of *Amicus* Eagle Forum that the "promote [] Progress" requirement is an independent constraint on Congress' power. The court held instead that it should not reach *Amicus's* argument because petitioners had not expressly adopted it in their brief. App. 11a.[2] In response to Judge Sentelle's two dissents, however, the court stated that, had it reached the argument of *Amicus*, it would have rejected that argument. App. 11a, App. 25a. That argument has therefore not been waived in this Court. *See Virginia Bankshares, Inc. v. Sandberg*, 501 U.S. 1083, 1099 n.8 (1991) ("[i]t suffices for our purposes that the court below passed on the issue presented").

4. Judge Sentelle dissented from the panel's decision with respect to the Copyright Clause claims. App. 16a. Following this Court's approach in *United States v. Lopez*, 514 U.S. 549 (1995), and *United States v. Morrison*, 529 U.S. 598 (2000), Judge

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[2] Petitioners expressly endorsed the argument of *Amicus* at oral argument before the D.C. Circuit. Tr. of Oral Arg. 17-18; App. 29a. In light of circuit authority, petitioners did not believe it was necessary to view the "grant of power" as an independent "substantive" constraint on Congress' Copyright authority. App. 11a. Petitioners continue to agree with Eagle Forum that the CTEA is unconstitutional under either the narrow rule that petitioners have advanced, or under the broader argument endorsed by Eagle Forum.

Sentelle reasoned that a court must find the "outer limits" to a power granted Congress. To find this "outer limit," Judge Sentelle asked whether "the rationale offered in support of [the extension of power] has any stopping point." App. 16a (Sentelle, J., dissenting). In this case, the answer was "no." The government had argued that any extension would be constitutional so long as it was "limited." App. 18a. That "rationale," Judge Sentelle reasoned, led to an "unlimited view of the copyright power"—just the same sort of "unlimited view" that this Court had "rejected with reference to the Commerce Clause in *Lopez*." App. 17a.

Instead, Judge Sentelle maintained that the proper limit to Congress' power is found by "returning to the language of the clause itself"—in particular, its "grant of power." Interpreting that language, Judge Sentelle wrote:

> [I]t is impossible that the Framers of the Constitution contemplated permanent protection, either directly obtained or attained through the guise of progressive extension of existing copyrights. . . . Extending existing copyrights is not promoting useful arts, nor is it securing exclusivity for a limited time.

App. 18a-19a.[3] Thus, Judge Sentelle concluded, a law that purports to extend the term of a subsisting copyright is beyond Congress' Copyright Clause power. App. 19a.

5. Petitioners filed for rehearing and rehearing *en banc*. The panel declined rehearing, and the D.C. Circuit denied rehearing en banc. App. 24a. Judge Sentelle, joined by Judge Tatel,

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[3] *See also* Jane C. Ginsburg, *Copyright Legislation for the "Digital Millennium,"* 23 Colum.-VLA J.L. & Arts 137, 171 (1999) (extending term of existing works "cannot enhance the quantum of creativity from the past, but it can compromise the creativity of the future, by delaying for twenty years the time at which subsequent authors may freely build on these works."); Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 Harv. L. Rev. 281, 329 n.192 (1970) (arguing that an "additional incentive to produce is irrelevant").

dissented from the denial of rehearing en banc. Judge Sentelle argued that en banc review was merited both because the rule of the panel "effectively eliminates any role for *amicus curiae* in the practice of this circuit," App. 28a (Sentelle, J., dissenting), and, "more importantly," because "the Court's construction of the Copyright Clause . . . renders Congress' power under Art. I, § 8, cl. 8, limitless despite express limitations in the terms of that clause." App. 31a. As Judge Sentelle wrote,

> Once a work is published . . . extending the copyright term does absolutely nothing to induce further creative activity by the author—and how could it? The work is already published [and a] simple finding by Congress to the contrary is not sufficient to demonstrate that the exercise of that power is "necessary and proper."

Id.

REASONS FOR GRANTING THE WRIT

As this Court has made increasingly clear, Congress' power is constrained by both express and implied limitations in the Constitution's grants of power. These constraints can inhere "in the very language" of the grant itself. *United States v. Lopez*, 514 U.S. 549, 553 (1995) (commerce clause); *Kimel v. Florida Bd. of Regents*, 528 U.S. 62, 81 (2000) ("the same language that serves as the basis for the affirmative grant of congressional power also serves to limit that power"). They can be found in the express terms conditioning particular grants of constitutional power. *Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457 (1982) (uniformity requirement in bankruptcy clause). Or they can flow from "presupposition[s]" that the Constitution "confirms." *Blatchford v. Native Village of Noatak*, 501 U.S. 775, 779 (1991) (11th Amendment).

The power at issue in this case is also and likewise constrained. Congress' power to grant "exclusive right[s]," incident to the power "To promote the Progress of Science," is expressly limited by the text of the Copyright and Patent Clause. It is expressly limited by the First Amendment. And it is

impliedly limited to works that are "original." *Feist Publ'ns v. Rural Tel. Sen. Co.*, 499 U.S. 340, 345 (1991).

These limitations were established by the Framers to assure a rich public domain, and to avoid the temptation to corruption that state-backed monopolies (as the Framers understood copyrights to be[4]) inevitably invite. They thus effected a regime that requires that monopolies over speech only be granted as a *quid pro quo* for producing something new—as this Court described it, for producing something that "add[s] to the sum of useful knowledge." *Graham v John Deere Co.*, 383 U.S. 1, 6 (1966). *See also Brenner v. Manson*, 383 U.S. 519, 534 (1966) (describing "[t]he basic *quid pro quo* contemplated by the Constitution"). *See generally* Paul J. Heald and Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119, 1162-63 (2000) (describing "*quid pro quo* principle").

The question in this case is whether this same power to grant monopolies as a *quid pro quo* for creating original works can also be used to grant monopolies to "something already in existence," *Trade-Mark Cases*, 100 U.S. 82, 94 (1879)—*quid*

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[4] *See* 1 THE REPUBLIC OF LETTERS 512, 566 (James Morton Smith ed., 1995). Jefferson was strongly opposed to the Constitution's grant of power to Congress to create monopolies. As he wrote to Madison, "It is better . . . to abolish . . . Monopolies, in all cases, than to do it in any . . . . The saying there shall be no monopolies lessens the incitements to ingenuity, which is spurred on by the hope of a monopoly for a limited time, as of 14 years; but the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression." 13 THE PAPERS OF THOMAS JEFFERSON 442-43 (Julian P. Boyd ed., 1956). Madison's response concedes the general fear. "With regard to Monopolies they are justly classed among the greatest nuisances in Government. But is it clear that as encouragements to literary works and ingenious discoveries, they are not too valuable to be wholly renounced?" *Id.* at 21. *See also* Paul J. Heald and Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119, 1150, 1160-62 (2000) (describing the suspect nature of a grant of power to secure monopolies).

pro nihilo. The court below held that it can, finding that extensions of subsisting terms were constitutional so long as each extension is limited. App. 9a-11a.

This holding nullifies the Framers' plan. By abstracting the term "limited Times" from the full text of the Copyright Clause, the circuit court has rendered meaningless the Framers' plain and express intent to restrict the duration of monopolies over speech. Under the authority of this case, Congress can now continue the practice of extending the term of subsisting copyrights without limit. It can thus achieve a perpetual copyright term "on the installment plan." Statement of Professor Peter Jaszi, *The Copyright Term Extension Act of 1995: Hearings on S.483 Before the Senate Judiciary Comm.*, 104th Cong. (1995), *available at* 1995 WL 10524355, at *6.

The "installment plan" was not the Framers' plan, and this Court should grant review to reverse this holding—both because of the significance of the issues at stake, especially as it they affect the emergence of the Internet, and because of the conflicts in the lower courts that this case evinces about the nature of Congress' Copyright Power.

Because of the CTEA, an extraordinary range of creative invention will be blocked from falling into the public domain until at least 2019—or longer if Congress extends the copyright term again. Thus, just at the time that the Internet is enabling a much broader range of individuals to draw upon and develop this creative work "without restraint," Story, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES § 502, at 402, extensions of copyright law are closing off this medium to a broad swath of our common culture.[5]

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[5] The significance of the CTEA is only multiplied by the other changes that Congress has made to copyright law. Because protection is automatic, and there is no longer any requirement of renewal, *see* Pub. L. 102-307, title I, § 102(a) & (d), 106 Stat. 264, 266 (repealing renewal requirement), an extraordinary range of creative work now falls into a regulatory black hole—unusable because the "owners" of this property are unknown or unknowable,

This Court should also grant review to resolve the confusion among the circuits both about the scope of Congress' Copyright Clause and about the interaction between Congress' copyright power and the First Amendment. The decision below conflicts with the Fifth Circuit's interpretation of Congress' copyright power, and reveals tensions with other circuits about the same power. The decision also conflicts with the Eleventh Circuit's approach to resolving alleged conflicts between the Copyright Clause and the First Amendment. This case provides the Court with an opportunity to resolve both dimensions of this confusion in authority.

I. THIS COURT SHOULD GRANT CERTIORARI TO RESOLVE A CONFLICT IN THE CIRCUITS ABOUT THE LIMITS ON CONGRESS' POWER UNDER THE COPYRIGHT AND PATENT CLAUSE.

The Copyright and Patent Clause gives Congress the power:

> To promote the Progress of Science and useful Arts, by securing for limited Times, to Authors and Inventors, the exclusive Right to their respective Writings and Discoveries.

U.S. Const., art. I, § 8, cl. 8.

As this Court has held, the Copyright Clause is "both a grant of power and a limitation." *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489

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and because the law criminalizes the use of such material without the copyright owner's permission. *See* No Electronic Theft Act of 1997, Pub. L. No. 105-147, 111 Stat. 2678 ("NET Act"), amending 17 U.S.C. § 506(a). These changes dramatically affect the work of artists, researchers, and archivists, as well as commercial entities that draw upon and reuse aspects of our culture. Rather than the rich public domain the Framers envisioned, upon which any may draw "without restraint," the effect of these changes is to create a mine field of regulations, extending copyright more broadly than at any time in our history. *See also* Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 Stan. L. Rev. 1, 13-20 (2001) (describing how the expansion of copyright law should alter the "definitional balance" with the First Amendment).

U.S. 141, 146 (1989) ("a grant of power and certain limitations upon the exercise of that power"). The "grant of power," as Judge Sentelle described it in dissent below, is the power "[t]o promote the progress of science and useful arts." App. 16a (Sentelle, J., dissenting). The means for exercising that power are those specified in the "by" clause—through "exclusive Right[s]" to "Authors" for their "Writings" for "limited Times."

The issue in this case is whether this "grant of power" also constrains Congress' Copyright Clause power—as this Court has held, for example, of Section 5 of the Fourteenth Amendment. *Kimel v. Florida Bd. of Regents*, 528 U.S. at 81 ("the same language that serves as the basis for the affirmative grant of congressional power also serves to limit that power"). Petitioners have argued that, at a minimum, the "promote [] Progress" requirement should inform the interpretation of the balance of the Clause, including the "limited Times" condition. *Cf. Wheaton v. Peters*, 33 U.S. (8 Peters) 591, 661 (1834) (Copyright Clause to be interpreted "with the words and sentences with which it stands connected"). So understood, a term is "limited" if it can reasonably be said to "promote the Progress of Science." Retrospective terms, which grant protection for work already in existence, could not in this sense be "limited."

Amicus Eagle Forum advanced a more expansive claim—that the "grant of power" should itself limit Congress' copyright authority, independent of the limitations expressed in the "by" clause. Under this reading, even if a copyright term were properly "limited," it must also be shown to "promote[] Progress."

The Court of Appeals rejected both arguments. Considering itself bound by its own circuit precedent, *Schnapper v. Foley*, 667 F.2d 102, 112 (D.C. Cir. 1981), the court rejected the argument that "the introductory language of the Copyright Clause constitutes a limit on congressional power." App. 10a. The D.C. Circuit thereby "erase[d]," as Judge Sentelle wrote in dissent to the denial of rehearing *en banc*, "half of the Copyright

Clause—indeed, that half which defines the very power bestowed." App. 33a.

The Court of Appeals' holding contradicts this Court's authority, conflicts with the rule of the Fifth Circuit, and is in tension with the approach of at least four other circuits.

A. The Decision Below Conflicts With Authority Of This Court

As petitioners have argued, this Court has expressly held that the Patent and Copyright Clause is "both a grant of power and a limitation." *Graham*, 383 U.S. at 5. The "limitation" referenced in *Graham*, however, is not just the express limitation within the "by" clause—that terms are to be "limited," or that copyrights are to be granted to "Authors" for their "Writings." Instead, this Court has recognized important substantive limitations on Congress' Copyright Clause power that can *only* be understood to flow from the "promote the Progress of Science" requirement. The holding by the court below that "the introductory language" imposed no "limit" on Congress' Copyright Clause power contradicts this authority.

1. In *Graham* this Court explained that it would be beyond Congress' constitutional power to grant a patent to a work in the public domain. As the Court wrote, "Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available." 383 U.S. at 6. The court below indicated the same principle would limit Congress' power, "*mutatis mutandis*," with respect to copyrights. App. 9a. *Accord Bonito Boats*, 489 U.S. at 146; *Gates Rubber Co. v. Bando Chem. Indus.*, 9 F.3d 823 (10th Cir. 1993).[6]

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[6] The court below so indicated, even though the government informed the court during oral argument that Congress has purported to remove copyrighted works from the public domain. *See* Tr. of Oral Arg. 37-38, referring to the Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514 (codified at 17 U.S.C. §§ 104A, 109(a)).

In both cases, however, the only possible source of such a restriction is the "promote the Progress of Science" requirement itself. There is no "public domain clause" in the Constitution. Works in the public domain clearly have "Authors"; they certainly include "Writings"; and Congress could plainly authorize such public domain copyrights for a "limited time." Absent the requirement that Congress "promote the Progress of Science," there would be no Copyright Clause reason to restrict Congress' power over the public domain. Yet this Court has clearly and repeatedly indicated that such a power is beyond Congress' Patent and Copyright Clause power. *See, e.g.*, *Graham*, 383 U.S. at 6; *Bonito Boats*, 489 U.S. at 146. That conclusion is flatly inconsistent with the holding below.[7]

2. Likewise with the requirement of "originality": As this Court has held, the only "Writings" that Congress may authorize for copyright protection are those that are "original." *Feist Publ'ns*, 499 U.S. at 345. "Originality" is a constitutional requirement—the "*sine qua non* of copyright. . . ." *Id.* As the *Trade-Mark Cases* held, the patents and copyrights clause power cannot extend to "something already in existence," 100 U.S. at 94 (1879), only something new.

But the Patent and Copyright Clause does not mention the term "original," and there is no doubt that under a literal reading of the term "Writings," "Writings" could include original as well as non-original works. If there is a constitutional limitation on the scope of the "Writings" to which Congress may extend copyright, then this limitation must derive from the "promote the Progress of Science" requirement. There is no other textual source for this restriction on Congress' otherwise plenary power. This conclusion again, however, flatly contradicts the conclusion of the Court of Appeals below.

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[7] The Court of Appeals recognized the tension between the circuit authority, *Schnapper v. Foley*, 667 F.2d 102 (D.C. Cir. 1981), and this Court's opinion in *Graham*. *See* Tr. of Oral Argument 29-31.

3. These two lines of authority compel the conclusion that the "promote the Progress of Science" requirement constrains Congress' power under the Copyright Clause. Whether it constrains Congress' power by narrowing the scope of the terms within the "by" clause, including the "limited Times" condition, or, as *Amicus* Eagle Forum argued, by independently constraining Congress' copyright authority, the conclusion of the court below to the contrary is clearly wrong. The D.C. Circuit's opinion has rendered the "To promote the Progress of Science" requirement of the Copyright Clause mere "surplusage." *Lopez*, 514 U.S. at 589 (Thomas, J., concurring). The Framers and this Court clearly intended that it be much more.

B. The Decision Below Conflicts With The Rule Of The Fifth Circuit And With Authority From Other Circuits

The decision below also contradicts the rule of the Fifth Circuit, and is in tension with the approach of at least four other circuits.

In *Mitchell Brothers Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979), the Fifth Circuit addressed the question whether Congress could constitutionally grant copyrights to obscene works. Cinema Adult Theater argued that obscene works did not "promote the progress of Science and useful Arts," and were therefore not authorized under Congress' power "to promote the Progress of Science." *Id.* at 860.

The Fifth Circuit rejected Cinema Adult Theater's argument—but not because it believed Congress free of any constraint from the "promote[] Progress" requirement. To the contrary, the Court expressly acknowledged that while the "words of the copyright clause" do not require that *individual* copyrights be shown to "promote science or useful arts," they plainly do "require that *Congress* shall promote those ends." *Id.* at 859 (emphasis added) (citations omitted). And while the Court recognized that Congress has broad discretion in selecting the means that it believes may promote progress, the Fifth Circuit

clearly recognized that "Congress' power under this Clause *is limited to action that promotes the useful arts*." *Id.* at 860 (emphasis added).

The Seventh Circuit has embraced the same rule. In interpreting the scope of a claimed patent monopoly, then-Judge Stevens wrote for the Seventh Circuit,

> The source and purpose of the statutory monopoly must be kept in mind. "An author's 'Writing' or an inventor's 'Discovery' can, in the constitutional sense, only extend to that which is his own. It may not be broadened to include matters within the public domain. *The congressional power to grant monopolies for 'Writings and Discoveries' is likewise limited to that which accomplishes the stated purpose of promoting 'the Progress of Science and useful Arts.'*"

Frantz Mfg. Co. v. Phenix Mfg. Co., 457 F.2d 314, 327 n.48 (7th Cir. 1972) (emphasis added)(quoting *Lee v. Runge*, 404 U.S. 887, 890 (1971) (Douglas, J., dissenting from denial of certiorari)). The Seventh Circuit also followed a similar principle in a subsequent case interpreting the scope of joint authorship under the Copyright Act. That question should be resolved, the court held, by "focus[ing] on how well the test promotes the primary objective of the Act. This objective is not to reward an author for her labors, but 'to promote the Progress of Science and useful Arts.'" *Erickson v. Trinity Theatre*, 13 F.3d 1061, 1069 (7th Cir. 1994). *See also J.L. Mott Iron Works v. Clow*, 82 F. 316, 320 (7th Cir. 1897) ("Under the constitution, the power lodged with congress is not unlimited, but is restricted to the promotion of the progress of science and useful arts.").

The Ninth Circuit has followed the same method to narrow the scope of joint authorship. In *Aalmuhammed v. Lee*, 202 F.3d 1227, 1235 (9th Cir. 1999), the court indicated that "[t]he Constitution establishes the social policy that our construction of the statutory term 'authors' carries out. The Founding Fathers gave Congress the power to give authors copyrights in order 'to promote the progress of Science and useful arts.'"

The Second Circuit, too, has followed this method to guide the interpretation of the scope of "fair use." "Fair use" is a limitation on the scope of copyright. The Second Circuit has interpreted this limitation in light of constitutional purpose: "to serve [the] purpose ['to promote the Progress of Science'], 'courts in passing upon particular claims of infringement must occasionally subordinate the copyright holder's interest in a maximum financial return to the greater public interest in the development of art, science, and industry.'" *Rosemont Enter. Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966)(citing *Berlin v. E.C. Publs.*, 329 F.2d 541, 544 (2d Cir. 1964) (Kaufman, J.)).

Finally, the Eleventh Circuit has applied a similar method to interpret the scope of Section 201(c) of the Copyright Act, governing contributions to collective works. It is in light of "fundamental principles," the court wrote, that the words of the Copyright Act are to be interpreted. *Greenberg v. Nat'l Geographic Soc'y*, 244 F.3d 1267, 1271 (11th Cir. 2001) ("In all cases involving copyright law, we understand that any interpretation and application of the statutory law must be consistent with the copyright clause of the United States Constitution . . . That clause is a limitation, as well as a grant, of the copyright power.") (citing Heald and Sherry, *supra*, 2000 U. Ill. L. Rev. 1119 (arguing the grant of power in the Copyright Clause constitutes a limit on Congress' copyright power, and concluding that retrospective extensions of copyright violate the Copyright Clause)).

The rule of the Fifth Circuit, and the approach of the Second, Seventh, Ninth, and Eleventh, is flatly inconsistent with the D.C. Circuit's conclusion that "the introductory language of the Copyright Clause constitutes [no] limit on congressional power." App. 10a. The conclusion of the Fifth Circuit is also inconsistent with the apparent rule of the Eighth Circuit. In a case that predates *Feist*, the Eighth Circuit held:

> [A]lthough the promotion of artistic and scientific creativity and the benefits flowing therefrom to the public are purposes of the Copyright Clause, *those purposes do not limit Congress's power to legislate in the field of copyright.*

Hutchinson Tel. Co. v. Fronteer Directory Co., 770 F.2d 128, 130 (8th Cir. 1985) (emphasis added).

This conflict will have significance far beyond the narrow issues of this case. Whether Congress is constrained by the plain language of the Copyright Clause will determine the scope of Congress' power to pass legislation to protect databases, or further to withdraw work from the public domain. Relying upon the view that the Constitution does not constrain it, some in Congress are presently pushing to expand the monopoly protections copyright law grants, without concern for whether these expansions truly "promote [] Progress." *See, e.g.*, The Collections of Information Antipiracy Act, H.R. 354, 106th Cong., 1st Sess. (1999) (extending copyright-like protection to facts within databases, *Feist* notwithstanding); Yochai Benkler, *Constitutional Bounds of Database Protection*, 15 Berkeley L. & Tech. J. 535, 575-87 (2000). Thus, waiting to clarify this conflict will only increase the costs of resolving it later.

By ignoring the "grant of power" and the purposes expressed in that grant, Congress has found a way to evade the Framers' clear intent. The D.C. Circuit has ratified that evasion. And Congress will now continue to act in reliance upon this ratification.

II. THIS COURT SHOULD GRANT CERTIORARI TO RESOLVE A CONFLICT IN THE CIRCUITS ABOUT THE RELATIONSHIP BETWEEN CONGRESS' COPYRIGHT POWER AND THE RESTRICTIONS OF THE FIRST AMENDMENT.

Petitioners have raised a First Amendment challenge to both the retrospective and prospective aspects of the CTEA. They argue that both aspects are content neutral regulations of speech and the press, and therefore subject to intermediate scrutiny. Under intermediate scrutiny, petitioners submit, neither the retrospective nor the prospective extension of the copyright term

"advances important governmental interests" without burdening "substantially more speech than necessary." *Turner Broad. Sys. v. FCC*, 520 U.S. 180, 189 (1997). *See also Bartnicki v. Vopper*, 121 S. Ct. 1753, 1760-61 (2001); *United States v. O'Brien*, 391 U.S. 367, 382 (1968).

The D.C. Circuit, however, refused to apply ordinary First Amendment analysis to the CTEA, holding instead that *Harper & Row* in effect established a special First Amendment "immunity" for copyright legislation. App 5a-8a. Under the D.C. Circuit's rule, there can be no First Amendment challenge to a copyright statute, as any challenge to a copyright statute is simply a demand for access to particular copyrighted works. Such a demand, the circuit court held, was rejected in *Harper & Row*. Thus it follows, the court concluded, that "copyrights are categorically immune from challenges under the First Amendment." App. 6a.

The D.C. Circuit's application of *Harper & Row* is clearly mistaken. It is also in direct conflict with the approach of the Eleventh Circuit. And, more importantly, it evinces a confusion that *Harper & Row* has engendered about whether the First Amendment imposes any constraint on Congress in its enactment of legislation under the Copyright Clause.[8] This conflict is another reason this Court should grant review in this case.

A. The D.C. Circuit Has Mistakenly Expanded The Reach Of This Court's Decision In *Harper & Row*

In *Harper & Row*, this Court was asked to craft a public figure exception in the enforcement of a copyright. *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 555-56 (1985). Harper & Row had an exclusive right to President Gerald

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[8] Professor Netanel attributes this confusion both to a misreading of the scope of *Harper & Row* and to a failure of courts to account for changes in First Amendment doctrine that would affect the interaction between the Copyright Clause and the First Amendment. *See* Netanel, *supra*, at 7-12.

Ford's autobiography. The Nation Magazine "scooped" part of that work without the copyright owner's consent. In defending against the enforcement of the copyright, The Nation argued that because the matter was of such public importance, First Amendment interests should trump Harper & Row's copyright interests. The Nation would therefore be excused from liability for trespassing on Harper & Row's right. The Nation did not argue that the copyright was invalid, or that copyright law could not extend to works such as this. It simply demanded that the First Amendment give it the right to trespass on the copyright owner's property.

This Court rejected The Nation's argument. As the Court explained, copyright functions as an "engine of free expression," *id.* at 558, by creating an incentive to produce speech that otherwise would not be produced. If a work lost its copyright protection simply because it became important, that would destroy much of the speech-inducing effect that copyright law produces. Thus, so long as copyright law regulates expression rather than ideas, *Harper & Row* holds that there is no First Amendment right to trespass on an otherwise legitimate copyright. *Id.* at 558-59. Private owners of intellectual property protected by copyright are able to exercise their rights free of the restrictions of the First Amendment, just as private owners of real property are generally able to exercise their rights free of the restrictions of the First Amendment. *Cf. Lloyd Corp. v. Tanner*, 407 U.S. 551 (1972) (no first amendment right to trespass on real property).

The overwhelming majority of courts applying the *Harper & Row* rule have done so in the same factual context: In these cases, *Harper & Row* is relied upon to deflect a purported First Amendment right of access to otherwise legitimately copyrighted material.[9]

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[9] *See, e.g.*, *Worldwide Church of God* v. *Philadelphia Church of God*, 227 F.3d 1110, 1115-16 (9th Cir. 2000) (infringement case rejects First Amendment defense) (citing *Harper*); *Religious Tech. Ctr.* v. *Henson*, 1999

U.S. App. Lexis 11828, at *3 (9th Cir. 1999) (in "copyright infringement action" court relies upon *Harper* to hold "the Copyright Act already embrace[s] First Amendment concerns"); *Cable/Home Comm. Co.* v. *Network Prod., Inc.*, 902 F.2d 829, 850 (11th Cir. 1990) (rejecting "First Amendment affirmative defense regarding . . . copyright . . . violations," court held "first amendment is not a license to trammel on legally recognized rights in intellectual property") (citing *Harper*) (citations omitted); *New Era Publ'ns* v. *Henry Holt & Co.*, 873 F.2d 576, 584 (2d Cir. 1989) (in injunction action to stop publication of allegedly infringing work, court rejects First Amendment defense: "Our observation that the fair use doctrine encompasses all claims of first amendment in the copyright field . . . never has been repudiated.") (citing *Harper*); *United Video* v. *FCC*, 890 F.2d 1173, 1190-91 (D.C. Cir. 1989) (court rejects petitioners' demand for access to copyrighted works "paid for and authorized under the compulsory licensing scheme" of the Copyright Act, holding "cases in which a first amendment defense is raised to a copyright claim do not utilize [intermediate scrutiny]") (citing *Harper*); *Los Angeles Times* v. *Free Republic*, 2000 U.S. Dist. Lexis 5669, at *78 (C.D. Ca. 2000) (rejecting defendant's First Amendment defense to copyright infringement, court held "courts have generally interpreted this discussion in *Harper & Row* to mean that First Amendment considerations are subsumed within the fair use analysis"); *Wojnarowicz* v. *American Family Ass'n*, 745 F. Supp. 130, 146-47 (S.D.N.Y. 1990) (in infringement action, court rejects First Amendment defense) (citing *Harper*); *Consumers Union of United States* v. *New Regina Corp.*, 664 F. Supp. 753, 761 n.10 (S.D. N.Y. 1987) (in infringement action, court rejects First Amendment defense) (citing *Harper*). Other courts have reached the same conclusion without applying *Harper* directly. *See A&M Records, Inc.* v. *Napster, Inc.*, 239 F.3d 1004, 1028 (9th Cir. 2001) (in infringement action, "First Amendment concerns in copyright are allayed by the presence of the fair use doctrine"); *Nihon Keizai Shimbun, Inc.* v. *Comline Bus. Data, Inc.*, 166 F.3d 65, 74-75 (2d Cir. 1999) (rejecting First Amendment defense to injunction enforcing copyright); *Twin Peaks Prod., Inc.* v. *Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1378 (2d Cir. 1993) (in an infringement action, court concludes "the fair use doctrine encompasses all claims of first amendment in the copyright field"); *Fisher* v. *Dees*, 794 F.2d 432, 434 n.2 (9th Cir. 1986) (rejecting First Amendment defense for parodists); *Roy Export Co.* v. *CBS*, 672 F.2d 1095, 1099-1100 (2d Cir. 1982) (in infringement action, court concludes "no Circuit that has considered the question . . . has ever held that the First Amendment provides a privilege in the copyright filed distinct from the accommodation embodied in the "fair use" doctrine); *Dallas Cowboys Cheerleaders, Inc.* v. *Scoreboard Poster., Inc.*, 600 F.2d 1184, 1188 (5th Cir. 1979) (in infringement action, "first amendment is not a license to trammel on legally recognized rights in intellectual property"); *Wainwright Sec. Inc.* v. *Wall Street Transcript Co.*, 558 F.2d 91, 95 (2d Cir. 1977) (in infringement

The court below has now expanded this unexceptional holding to cover any First Amendment challenge within the domain of copyright—not just to the enforcement of a particular copyright, but also to a challenge of the statutes under which copyrights are established. Because there is no First Amendment right to trespass, the court below has held that there can be no First Amendment right to challenge the legal rule under which the property rights are set.

That conclusion cannot follow—as the D.C. Circuit's own authority in the context of abortion protester cases shows.[10] In those cases, the D.C. Circuit has rightfully held that there "is no general First Amendment right to trespass." *NOW v. Operation Rescue*, 37 F.3d 646, 655 (D.C. Cir. 1994). But the absence of a "First Amendment right to trespass" cannot mean that an abortion protester cannot challenge the law or injunction

action, court rejects First Amendment defense); *Georgia Television Co.* v. *TV News Clips of Atlanta*, 718 F. Supp 939, 947 (N.D. Ga. 1989) (in infringement action, court holds "conflicts between interests protected by the first amendment and copyright laws thus far have been resolved by application of the fair use doctrine") (citations omitted); *Walt Disney Co.* v. *Powell*, 698 F. Supp. 10, 12 (D.D.C. 1988), *vacated in part*, 897 F.2d 565 (D.C. Cir. 1990) (First Amendment "gives no right to steal another's statutorily protected intellectual property").

[10] That it does not follow can also be seen in the source of the *Harper & Row* rule itself. As many have noted, this Court in *Harper & Row* drew its "definitional balance" from the work of noted copyright scholar Melville Nimmer. *See e.g.*, Netanel, *supra*, at 11-12. Nimmer had first proposed this "balance" between the First Amendment and copyright in an important article published in 1970. Melville B. Nimmer, *Does Copyright Abridge The First Amendment Guarantees of Free Speech And Press?*, 17 UCLA L. REV. 1180 (1970). In that article, Nimmer argued that so long as copyright protected expression only, there should ordinarily be no First Amendment claim that could be raised against the assertion of a copyright. *See id.* at 1197-99.

But in the very same article, Nimmer goes on to address the First Amendment interests affected by a retrospective extension of copyright. He concluded, as petitioners have argued, that such an extension would violate the First Amendment. *Id.* at 1194-95. His "definitional balance" therefore cannot be read to preclude this conclusion.

establishing the property right that is allegedly trespassed upon. State action *establishing* property rights is fully subject to First Amendment scrutiny, even if private action *exercising* these state established rights is subject to a narrower First Amendment rule. The D.C. Circuit's conclusion to the contrary is simply mistaken. *Cf. Denver Area Educ. Telecomms. Consortium v. FCC*, 518 U.S. 727, 737 (1996) (in reversing the D.C. Circuit's finding of no state action, this Court held that, though editorial decisions by cable system operators are not themselves state action, a statute giving operators such discretion is fully subject to First Amendment review).

B. The Opinion Below Conflicts With The Rule Of The Eleventh Circuit.

The decision below, refusing to apply ordinary First Amendment analysis to a statute modifying the Copyright Act, is in direct conflict with the Eleventh Circuit.

In *CBS Broadcasting Inc. v. EchoStar Communications Corp.*, No. 00-15378, 2001 WL 1081599 (11th Cir. Sept. 17, 2001), the Court of Appeals for the Eleventh Circuit upheld a provision of the Satellite Home Viewer Act, 17 U.S.C. § 119, and Satellite Home Viewer Improvement Act of 1999 ("Improvement Act"), Pub. L. No. 106-133, § 1001 *et seq.*, 113 Stat. 1537, 515 (West Supp. 2001), against a First Amendment challenge. The Improvement Act gave satellite carriers the right to a compulsory license for network programming delivered to private homes in "unserved households." *Id.* at *1. Defendant EchoStar challenged the statutory scheme, arguing that the distinction the statute drew was content based, and unjustified under the First Amendment.

The Eleventh Circuit rejected EchoStar's First Amendment claim. Unlike the D.C. Circuit, however, the Eleventh Circuit reached this conclusion by applying ordinary First Amendment analysis to the challenged statute. The court treated the Improvement Act as a content neutral regulation of speech. *Id.* at *14. It thus proceeded to apply intermediate scrutiny to that

content neutral copyright regulation, concluding that the restrictions served important governmental interests unrelated to the suppression of speech, and that those restrictions on "First Amendment freedoms [were] no greater than is essential to the furtherance of" those interests. *Id.* at *14-16.

Although defendant EchoStar was defending against a copyright infringement action brought by CBS and others, *id.* at *1, and although the Eleventh Circuit, like the D.C. Circuit, treated *Harper & Row* as setting the framework for its analysis, *id.* at *13, unlike the D.C. Circuit, the Eleventh Circuit did not treat *Harper & Row* as exhausting First Amendment analysis of the Improvement Act. Instead, the Eleventh Circuit expressly weighed the defendant's First Amendment interest according to ordinary First Amendment analysis. Intermediate scrutiny *of the statute* was appropriate, the court held, even though *Harper & Row* had rejected a First Amendment right to trespass *on particular copyrights*. *Id.* at *15.

Petitioners asked both courts below to apply the same test to the CTEA. Both courts refused. But under the reasoning of the Eleventh Circuit, petitioners would have been entitled to intermediate scrutiny. Indeed, petitioners' claim for intermediate scrutiny would have been stronger analysis than the defendant's in *EchoStar*. Unlike that defendant, petitioners do not claim a right to use otherwise legitimately copyrighted material; petitioners instead argue that the material at issue cannot legitimately be copyrighted. We challenge a statute that purports to create copyrights in a manner that is inconsistent with the First Amendment. But unlike the Court of Appeals for the Eleventh Circuit, neither the District Court nor the D.C. Circuit applied intermediate review of the CTEA. Instead, both courts treated *Harper & Row* as exhausting First Amendment analysis of a copyright statute.

This Court should grant review in this case to resolve this conflict. If *Harper & Row* indeed establishes the rule that copyright law is "immune from challenges under the First Amendment," then that rule is not being followed in at least the

Eleventh Circuit, as *EchoStar* demonstrates, nor possibly within the Second Circuit. *See Universal City Studios v. Reimerdes,* 111 F. Supp. 2d 294, 327-29 (S.D.N.Y. 2000) (applying intermediate scrutiny to Digital Millennium Copyright Act) (appeal pending). If, instead, *Harper & Row* simply establishes that the exercise of a copyright by a copyright holder is not subject to intermediate First Amendment scrutiny, then the decision below will short-circuit ordinary First Amendment review of copyright legislation in a range of related cases. As this confusion follows from *Harper & Row* itself, this Court should grant review to clarify the scope of the principle announced in *Harper & Row*.

Petitioners submit that outside the context of a First Amendment challenge to the assertion of an otherwise legitimate copyright (*i.e.,* a First Amendment right to trespass), ordinary First Amendment analysis should apply. There is no textual reason to exempt copyright law from ordinary First Amendment analysis. Nor is there any history to suggest that the Framers imagined copyright law to be exempt from First Amendment review. To the contrary, at least some expected that the First Amendment would be a check against unrestrained copyright power.[11] If a *sui generis* trademark law gets ordinary First Amendment review, *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987), and regulations of the treasury governing currency get ordinary First Amendment review, *Regan v. Time, Inc.*, 468 U.S. 641 (1984), then petitioners

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[11] As a delegate to the Pennsylvania ratifying convention argued, in support of a First Amendment,

> Tho[ugh] it is not declared that Congress have a power to destroy the liberty of the press; yet, in effect, they will have it .... They have a power to secure to authors the right of their writings. Under this, they may license the press, no doubt; and under licensing the press, they may suppress it.

2 THE DOCUMENTARY HISTORY OF THE RATIFICATION OF THE CONSTITUTION: RATIFICATION OF THE CONSTITUTION BY THE STATES: PENNSYLVANIA 454 (Merrill Jensen ed., 1976).

submit that copyright law is also constrained by the ordinary rules of the First Amendment.[12]

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[12] For a catalogue of contexts in which the First Amendment has been held to constrain private rights, see Netanel, *supra*, at n.12 (including private rights of privacy, protection against intentional infliction of emotional distress, libel, trademark, tortious interference with business relations, right of publicity, and trade secret protection).

CONCLUSION

For the forgoing reasons, petitioners submit that this Court should grant review in this case to reverse the holding of the D.C. Circuit with respect to Congress' power to grant copyrights retrospectively under the Copyright Clause. Petitioners would also ask this Court to remand the case to the District Court to apply intermediate scrutiny under the First Amendment to both the retrospective and prospective aspects of the CTEA.[13]

Respectfully submitted,

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[13] This case also presents a question for review about whether a Court of Appeals must ignore an argument made by an *Amicus* for a claim properly raised simply because a party has not expressly adopted that argument in its brief. In the court below, *Amicus* Eagle Forum argued that the "promote the Progress of Science" clause was an independent constraint on Congress' Copyright Clause power. While petitioners expressly embraced that argument at oral argument, App. 29a (Sentelle, J., dissenting), the D.C. Circuit held that *Ashwander* v. *Tennessee Valley Authority*, 297 U.S. 288, 346 (1936) (Brandeis, J., concurring), required that it could not consider the argument of *Amicus*. This conclusion is wrong as an application of *Ashwander*, but this Court need not resolve this error. Because there is no doubt that petitioners have raised and properly preserved the claim that the extension of copyright terms is beyond Congress' Copyright Clause power, App. 31a (Sentelle, J., dissenting), and because the court below nonetheless considered and rejected the argument of *Amicus*, App. 11a-12a, 25a, there is technically no need for the Court to review this question in this appeal. Nonetheless, petitioners raise the question, and would defend the *Amicus's* right, to give this Court the opportunity to clarify the role of *amici* in argument.

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October 11, 2001

APPENDIX

239 F.3d 372

**UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT.**

**Eric ELDRED, et al., Appellants,
v.
Janet RENO, In her official capacity as
Attorney General, Appellee.**

No. 99-5430.

Argued Oct. 5, 2000.
Decided Feb. 16, 2001.

Before: GINSBURG, SENTELLE, and HENDERSON, Circuit Judges.

Opinion for the Court filed by Circuit Judge GINSBURG.

Separate opinion dissenting in part filed by Circuit Judge SENTELLE.

GINSBURG, Circuit Judge:

The plaintiffs in this case, corporations, associations, and individuals who rely for their vocations or avocations upon works in the public domain, challenge the constitutionality of the Copyright Term Extension Act of 1998 (CTEA), Pub. L. No. 105-298, 112 Stat. 2827. This marks the first occasion for an appellate court to address whether the First Amendment or the Copyright Clause of the Constitution of the United States constrains the Congress from extending for a period of years the duration of copyrights, both those already extant and those yet to come. We hold that neither does.

I. Background

The CTEA amends various provisions of the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.* The portions of the CTEA at issue here extend the terms of all copyrights for 20 years as follows: (1) For a work created in 1978 or later, to which an individual author holds the copyright, the Act extends the term to the life of the author plus 70 years. *See* Pub. L. No. 105-298 § 102(b)(1), 112 Stat. 2827; 17 U.S.C. § 302(a). (2) For a work created in 1978 or later that is anonymous, or pseudonymous, or is made for hire, the term is extended from 75 to 95 years from the year of publication or from 100 to 120 years from the year of creation, whichever occurs first. *See* Pub. L. No. 105-298 § 102(b)(3), 112 Stat. 2827; 17 U.S.C. § 302(c). (3) For a work created before 1978, for which the initial term of copyright was 28 years, the renewal term is extended from 47 to 67 years, thereby creating a combined term of 95 years. *See* Pub. L. No. 105-298 § 102(d), 112 Stat. 2827; 17 U.S.C. § 304. In all three situations, therefore, the CTEA applies retrospectively in the sense that it extends the terms of subsisting copyrights. As a result, the CTEA better aligns the terms of United States copyrights with those of copyrights governed by the European Union. *See* S. Rep. No. 104-315, at 7-8 (1996); Council Directive 93/98, art. 7, 1993 O.J. (L 290) 9.

The CTEA is but the latest in a series of congressional extensions of the copyright term, each of which has been made applicable both prospectively and retrospectively. In 1790 the First Congress provided, both for works "already printed" and for those that would be "[t]hereafter made and composed," initial and renewal terms of 14 years, for a combined term of 28 years. Act of May 31, 1790 § 1, 1 Stat. 124, 124. In 1831 the Congress extended the initial term to 28 years, thereby creating a combined term of 42 years. *See* Act of Feb. 3, 1831 § 1, 4 Stat. 436, 436. So the term remained until 1909, when the Congress extended the renewal term as well to 28 years,

making for a combined term of 56 years. *See* Act of March 4, 1909 § 23, 35 Stat. 1075, 1080.

Between 1962 and 1974 the Congress passed a series of laws that incrementally extended subsisting copyrights. *See* Pub. L. No. 87-668, 76 Stat. 555 (1962); Pub. L. No. 89-142, 79 Stat. 581 (1965); Pub. L. No. 90-141, 81 Stat. 464 (1967); Pub. L. No. 90-416, 82 Stat. 397 (1968); Pub. L. No. 91-147, 83 Stat. 360 (1969); Pub. L. No. 91-555, 84 Stat. 1441 (1970); Pub. L. No. 92-170, 85 Stat. 490 (1971); Pub. L. No. 92-566, 86 Stat. 1181 (1972); Pub. L. No. 93-573, title I, § 104, 88 Stat. 1873 (1974). In 1976 the Congress altered the way the term of a copyright is computed so as to conform with the Berne Convention and with international practice. *See* H.R. Rep. No. 94-1476, at 135 (1976), U.S.C.C.A.N. at 5659, 5751. Thenceforth the term would be the life of the author plus 50 years or, where there was no identifiable author, the earlier of 75 years from the year of publication or 100 years from the year of creation. *See* Pub. L. No. 94-553 §§ 302-05, 90 Stat. 2541, 2572-76 (1976). The CTEA amends this scheme by adding 20 years to the term of every copyright.

The plaintiffs filed this suit against the Attorney General of the United States to obtain a declaration that the CTEA is unconstitutional. Among the plaintiffs are a non-profit association that distributes over the internet free electronic versions of books in the public domain; a company that reprints rare, out-of-print books that have entered the public domain; a vendor of sheet music and a choir director, who respectively sell and purchase music that is relatively inexpensive because it is in the public domain; and a company that preserves and restores old films and insofar as such works are not in the public domain, needs permission from their copyright holders—who are often hard to find—in order to exploit them.

The district court entered judgment on the pleadings in favor of the Government and dismissed the plaintiffs' case in its entirety. On appeal, the plaintiffs renew their claims that the

CTEA both violates the First Amendment to the Constitution and is in various ways inconsistent with the Copyright Clause of Article I, § 8 of the Constitution, which authorizes the Congress: "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

II. Analysis

The plaintiffs claim that the CTEA is beyond the power of the Congress and therefore unconstitutional for three reasons: first, the CTEA, in both its prospective and retrospective applications, fails the intermediate scrutiny appropriate under the First Amendment; second, in its application to preexisting works, the CTEA violates the originality requirement of the Copyright Clause; and third, in extending the term of subsisting copyrights, the CTEA violates the "limited Times" requirement of the Copyright Clause—a requirement that they say is informed by the goal of "promot[ing] the Progress of Science and useful Arts." Because each of these grounds presents a pure question of law, we consider them *de novo*. *See, e.g., United States v. Popa*, 187 F.3d 672, 674 (D.C. Cir. 1999).

A. First Amendment

The First Amendment aspect of the plaintiffs' complaint attacks the CTEA not only in its application to subsisting copyrights but also insofar as it extends the terms of copyrights for works yet to be created. The Government questions plaintiffs' standing to complain in the latter regard.

1. Standing

Consider first the plaintiffs' standing with respect to works that, though now subject to subsisting copyrights, will in due course enter the public domain: The plaintiffs benefit from using works in the public domain and, but for the CTEA, they would be able to exploit additional works the copyrights to

which would have expired in the near future. As such, they suffer an injury in fact that is traceable to the CTEA and that we could redress by holding the Act invalid. *See Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560-61 (1992). The Government concedes as much.

In view of the plaintiffs' standing to challenge the CTEA with respect to works already copyrighted, the Government's objection to the plaintiffs' standing with respect to works yet to be created seems very weak indeed. The plaintiffs benefit from works in the public domain and are deprived of that benefit so long as such works are under copyright. That is as true for works not yet created as for extant works on which the copyrights are about to expire; the Government does not draw any meaningful distinction between the two categories of works. We conclude therefore that the plaintiffs have standing to pursue their prospective claim under the First Amendment.

2. The merits

The decisions of the Supreme Court in *Harper & Row Publishers Inc. v. Nation Enters.*, 471 U.S. 539 (1985), and of this court in *United Video, Inc. v. FCC*, 890 F.2d 1173 (1989), stand as insuperable bars to plaintiffs' first amendment theory. In *Harper & Row* the Court held that a magazine's advance publication of excerpts from the memoirs of former President Gerald Ford infringed the copyright thereon. 471 U.S. at 569. In doing so the Court explained how the regime of copyright itself respects and adequately safeguards the freedom of speech protected by the First Amendment.

> [C]opyright's idea/expression dichotomy "strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression." No author may copyright his ideas or the facts he narrates. 17 U.S.C. § 102(b). *See e.g., New York Times Co. v. United States*, 403 U.S. 713, 726, n.* (1971) (BRENNAN, J., concurring)

(Copyright laws are not restrictions on freedom of speech as copyright protects only form of expression and not the ideas expressed).

Id. at 556 (citation omitted).

The first amendment objection of the magazine was misplaced "[i]n view of the First Amendment protections already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use." *Id.* at 560.

In keeping with this approach, we held in *United Video* that copyrights are categorically immune from challenges under the First Amendment. There, certain cable companies petitioned for review of an FCC regulation providing that the supplier of a syndicated television program could agree to the program being broadcast exclusively by a single station in a local broadcast area. 890 F.2d at 1176-78. We rejected the first amendment aspect of their challenge as follows:

> In the present case, the petitioners desire to make commercial use of the copyrighted works of others. There is no first amendment right to do so. Although there is some tension between the Constitution's copyright clause and the first amendment, the familiar idea/expression dichotomy of copyright law, under which ideas are free but their particular expression can be copyrighted, has always been held to give adequate protection to free expression.

890 F.2d at 1191.

The plaintiffs argue that "these authorities are restricted solely to the narrow case where a litigant demands a right to use otherwise legitimately copyrighted material," which case is "plainly distinct from [this] First Amendment challenge[ ] to the constitutionality of the statute granting a [copy]right in the first instance." We think the plaintiffs' purported distinction is

wholly illusory. The relevant question under the First Amendment—regardless whether it arises as a defense in a suit for copyright infringement or in an anticipatory challenge to a statute or regulation—is whether the party has a first amendment interest in a copyrighted work. The works to which the CTEA applies, and in which plaintiffs claim a first amendment interest, are by definition under copyright; that puts the works on the latter half of the "idea/expression dichotomy" and makes them subject to fair use. This obviates further inquiry under the First Amendment.

The plaintiffs cite no case to the contrary. In two of the cases they do cite, *Reno v. ACLU*, 521 U.S. 844, 871-79 (1997), and *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 115-23 (1991), the Supreme Court held statutes unconstitutional under the First Amendment because they were unjustifiably content based; the plaintiffs here do not claim that the CTEA is anything but content neutral. In *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, also cited by the plaintiffs, the Court did indeed apply heightened scrutiny under the First Amendment to a statute granting the United States Olympic Committee trademark-like protection for the word "Olympic." 483 U.S. 522, 535-41 (1987). Restricting the use of particular words "runs a substantial risk of suppressing ideas in the process," the Court explained. *Id.* at 532. As we have seen, however, copyright protection cannot embrace ideas; it therefore does not raise the same concern under the First Amendment. Finally, although the plaintiffs assert that the Second Circuit has reached the merits of a first amendment challenge to an aspect of the Copyright Act of 1976, in fact that court, after reviewing the case law, concluded that the plaintiffs categorically lacked "any right to distribute and receive material that bears protection of the Copyright Act." *Authors League of America v. Oman*, 790 F.2d 220, 223 (1986).

As this is all the support plaintiffs muster for their proposition, we need not linger further in disposing of it. Suffice it to say we reject their first amendment objection to the CTEA because the plaintiffs lack any cognizable first amendment right to exploit the copyrighted works of others.

B. Requirement of Originality

The plaintiffs' second challenge ostensibly rests upon *Feist Publications, Inc. v. Rural Telephone Service Co.*, in which the Supreme Court held that telephone listings compiled in a white pages directory are uncopyrightable facts: "The *sine qua non* of copyright is originality." 499 U.S. 340, 345 (1991). "Originality is a constitutional requirement" for copyright because the terms "Authors" and "Writings," as they appear in the Copyright Clause, "presuppose a degree of originality." *Id.* at 346.

The plaintiffs reason from this that the CTEA cannot extend an extant copyright because the copyrighted work already exists and therefore lacks originality. Not so. Originality is what made the work copyrightable in the first place. A work with a subsisting copyright has already satisfied the requirement of originality and need not do so anew for its copyright to persist. If the Congress could not extend a subsisting copyright for want of originality, it is hard to see how it could provide for a copyright to be renewed at the expiration of its initial term—a practice dating back to 1790 and not questioned even by the plaintiffs today.

The plaintiffs' underlying point seems to be that there is something special about extending a copyright beyond the combined initial and renewal terms for which it was initially slated. Nothing in *Feist* or in the requirement of originality supports this, however: All they tell us is that facts, like ideas, are outside the ambit of copyright. Undaunted in trying to advance their novel notion of originality, the plaintiffs point to cases that do not address the requirement of originality for

copyright *per se*. They point to no case or commentary, however, that calls into question the distinction between a new grant of copyright—as to which originality is an issue—and the extension of an existing grant. That distinction reflects, at bottom, the difference between the constitutionally delimited subject matter of copyright and the Congress's exercise of its copyright authority with respect to that subject matter.

The plaintiffs do point out that the Supreme Court has said the "Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available." *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966). The Court similarly stated, over a century ago, that the issuance of a trademark could not be justified under the Copyright Clause because the subject matter of trademark is "the adoption of something already in existence." *Trade-Mark Cases*, 100 U.S. 82, 94 (1879). Applied *mutatis mutandis* to the subject of copyright, these teachings would indeed preclude the Congress from authorizing under that Clause a copyright to a work already in the public domain.

The plaintiffs read the Court's guidance more broadly, in the light of *Feist*, to mean that a work in the public domain lacks the originality required to qualify for a copyright. That is certainly not inconsistent with the Court's opinion: A work in the public domain is, by definition, without a copyright; where the grant of a copyright is at issue, so too is the work's eligibility for copyright, and thus the requirement of originality comes into play. We need not adopt a particular view on that point, however, as it has nothing to do with this case. Here we ask not whether any work is copyrightable—indeed, the relevant works are already copyrighted—but only whether a copyright may by statute be continued in force beyond the renewal term specified by law when the copyright was first granted. For the plaintiffs to prevail, therefore, they will need

something other than the requirement of originality upon which to make their stand.

C. The Limitation of "limited Times"

We come now to the plaintiffs' contention that the CTEA violates the constitutional requirement that copyrights endure only for "limited Times." This claim at last speaks to the duration rather than to the subject matter of a copyright: If the Congress were to make copyright protection permanent, then it surely would exceed the power conferred upon it by the Copyright Clause.

The present plaintiffs want a limit well short of the rule against perpetuities, of course. And they claim to have found it—or at least a bar to extending the life of a subsisting copyright—in the preamble of the Copyright Clause: "The Congress shall have power . . . To promote the Progress of Science and useful Arts. . . ." Their idea is that the phrase "limited Times" should be interpreted not literally but rather as reaching only as far as is justified by the preambular statement of purpose: If 50 years are enough to "promote . . . Progress," then a grant of 70 years is unconstitutional. Here the plaintiffs run squarely up against our holding in *Schnapper v. Foley*, 667 F.2d 102, 112 (1981), in which we rejected the argument "that the introductory language of the Copyright Clause constitutes a limit on congressional power." The plaintiffs, however, disclaim any purpose to question the holding of *Schnapper*; indeed, they expressly acknowledge "that the preamble of the Copyright Clause is not a substantive limit on Congress' legislative power." Their argument is simply that "the Supreme Court has interpreted the terms 'Authors' and 'Writings' in light of that preamble, and that this Court should do the same with 'limited Times.' "

The problems with this argument are manifest. First, one cannot concede that the preamble "is not a substantive limit" and yet maintain that it limits the permissible duration of a

copyright more strictly than does the textual requirement that it be for a "limited Time." Second, although the plaintiffs claim that *Feist* supports using the preamble to interpret the rest of the Clause, the Court in *Feist* never suggests that the preamble informs its interpretation of the substantive grant of power to the Congress (which there turned upon the meaning of "Authors" and of "Writings," each standing alone). 499 U.S. at 345-47. Similarly, the *Trade-Mark Cases* cited in *Feist* rest upon the originality implied by "invention [and] discovery" and by the "writings of authors," and make no reference at all to the preamble. 100 U.S. at 93-94.

III. The Dissent

The foregoing suffices to dispose of plaintiffs' arguments—as Judge Sentelle, dissenting, implicitly recognizes—and hence to resolve this case. Our dissenting colleague nonetheless adopts the narrow view of *Schnapper* urged by an amicus, although that argument is rejected by the actual parties to this case and therefore is not properly before us. *See, e.g.*, 16A CHARLES ALAN WRIGHT, ARTHUR R. MILLER & EDWARD H. COOPER, FEDERAL PRACTICE AND PROCEDURE § 3975.1 & n.3 (3d ed.1999); *Resident Council of Allen Parkway Vill. v. HUD*, 980 F.2d 1043, 1049 (5th Cir. 1993) (amicus constrained "by the rule that [it] generally cannot expand the scope of an appeal to implicate issues that have not been presented by the parties to the appeal"); *cf. Lamprecht v. FCC*, 958 F.2d 382, 389 (D.C. Cir. 1992) (intervenor as nonparty "cannot expand the proceedings" or "enlarge those issues presented"). This is particularly inappropriate because a court should avoid, not seek out, a constitutional issue the resolution of which is not essential to the disposition of the case before it. Moreover, because the plaintiffs conspicuously failed to adopt the argument of the amicus, the Government was not alerted to any need to argue this point and did not do so. *See Harmon v. Thornburgh*, 878 F.2d 484, 494 (D.C. Cir. 1989) (court must "avoid unnecessary or

premature constitutional rulings" and this concern "is heightened by the absence of meaningful argument by the parties on [constitutional] question"); *Ashwander v. Tennessee Valley Authority*, 297 U.S. 288, 346 (1936) (Brandeis, J., concurring) ("Court will not 'anticipate a question of constitutional law in advance of the necessity of deciding it'").

Even were we to proceed as urged by the amicus and the dissent, however, we would only review the CTEA as we would any other exercise of a power enumerated in Article I. That is we would ask, following *McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 316, 421 (1819), whether the CTEA is a "necessary and proper" exercise of the power conferred upon the Congress by the Copyright Clause; assuming Judge Sentelle is correct and *Schnapper* is wrong about the relationship of the preamble to the rest of that Clause, this would require that the CTEA be an "appropriate" means, and "plainly adapted" to the end prescribed in the preamble, "promot[ing] Progress of Science and useful Arts." The Congress found that extending the duration of copyrights on existing works would, among other things, give copyright holders an incentive to preserve older works, particularly motion pictures in need of restoration. *See* S. Rep. No. 104-315, at 12 (1996). If called upon to do so, therefore, we might well hold that the application of the CTEA to subsisting copyrights is "plainly adapted" and "appropriate" to "promot[ing] progress." *See Ladd v. Law & Technology Press*, 762 F.2d 809, 812 (9th Cir. 1985) (upholding the deposit requirement of the Copyright Act of 1976 as "necessary and proper" because the purpose was "to enforce contributions of desirable books to the Library of Congress").

Judge Sentelle concludes otherwise only because he sees a categorical distinction between extending the term of a subsisting copyright and extending that of a prospective copyright. This distinction is not to be found in the Constitution itself, however. The dissent identifies nothing in text or

in history that suggests that a term of years for a copyright is not a "limited Time" if it may later be extended for another "limited Time." Instead, the dissent suggests that the Congress—or rather, many successive Congresses—might in effect confer a perpetual copyright by stringing together an unlimited number of "limited Times," although that clearly is not the situation before us. The temporal thrust of the CTEA is a good deal more modest: The Act matches United States copyrights to the terms of copyrights granted by the European Union, *see* Council Directive 93/98, art. 7, 1993 O.J. (L 290) 9; in an era of multinational publishers and instantaneous electronic transmission, harmonization in this regard has obvious practical benefits for the exploitation of copyrights. This is a powerful indication that the CTEA is a "necessary and proper" measure to meet contemporary circumstances rather than a step on the way to making copyrights perpetual; the force of that evidence is hardly diminished because, as the dissent correctly points out, the EU is not bound by the Copyright Clause of our Constitution. As for the dissent's objection that extending a subsisting copyright does nothing to "promote Progress," we think that implies a rather crabbed view of progress: Preserving access to works that would otherwise disappear—not enter the public domain but disappear—"promotes Progress" as surely as does stimulating the creation of new works.

The position of our dissenting colleague is made all the more difficult because the First Congress made the Copyright Act of 1790 applicable to subsisting copyrights arising under the copyright laws of the several states. *See* Act of May 31, 1790,

§§ 1 and 3, 1 Stat. 124-25.[1] The construction of the Constitution "by [those] contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight, and when it is remembered that the rights thus established have not been disputed [for this long], it is almost conclusive." *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57 (1884). The plaintiffs, recognizing the import of this "almost conclusive" point for their own theory, try to avoid it with the suggestion that application of the Act of 1790 to subsisting copyrights "is fully understandable under a Supremacy Clause analysis" in that it "clarif[ied] which law (state or federal) would govern th[o]se copyrights." But that will not do: A federal law is not valid, let alone supreme, if it is not first an exercise of an enumerated power. And the First Congress was clearly secure in its power under the Copyright Clause to extend the terms of subsisting copyrights beyond those granted by the States.

Such guidance as the Supreme Court has given further confirms us in this view of the matter. The Court has made plain that the same Clause permits the Congress to amplify the terms of an existing patent. As early as 1843 it established that the status of a particular invention and its protections

> must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made; for though they may be retrospective in their operation, that is not a sound objection to their validity; the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their

[1] Indeed, each of the four later Congresses that extended the terms of copyrights followed suit in doing so for subsisting as well as prospective copyrights. *See* Act of Feb. 3, 1831 § 1, 4 Stat. 436-39; Act of March 4, 1909 § 23, 35 Stat. 1075-88; Pub. L. No. 94-553 § 301, 90 Stat. 2541-2602 (1976); Pub. L. No. 105-298, 112 Stat. 2827 (2000).

> right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.

McClurg v. Kingsland, 42 U.S. (1 How.) 202, 206 (1843).

Within the realm of copyright, the Court has to the present era been similarly deferential to the judgment of the Congress. "As the text of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors or to inventors in order to give the appropriate public access to their work product;" that "task involves a difficult balance between [competing interests]" as reflected in the frequent modifications of the relevant statutes. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984). And still more recently: "Th[e] evolution of the duration of copyright protection tellingly illustrates the difficulties Congress faces [in exercising its copyright power]. . . . [I]t is not our role to alter the delicate balance Congress has labored to achieve." *Stewart v. Abend*, 495 U.S. 207, 230 (1990).

IV. Conclusion

In sum, we hold that the CTEA is a proper exercise of the Congress's power under the Copyright Clause. The plaintiffs' first amendment objection fails because they have no cognizable first amendment interest in the copyrighted works of others. Their objection that extending the term of a subsisting copyright violates the requirement of originality misses the mark because originality is by its nature a threshold inquiry relevant to copyrightability, not a continuing concern relevant to the authority of the Congress to extend the term of a copyright.

Whatever wisdom or folly the plaintiffs may see in the particular "limited Times" for which the Congress has set the duration of copyrights, that decision is subject to judicial review only for rationality. This is no less true when the Congress modifies the term of an existing copyright than when it

sets the term initially, and the plaintiffs—as opposed to one of the amici—do not dispute that the CTEA satisfies this standard of review. The question whether the preamble of the Copyright Clause bars the extension of subsisting copyrights—a question to which the analysis in *Schnapper* seems to require a negative answer—may be revisited only by the court sitting *en banc* in a future case in which a party to the litigation argues the point.

For the foregoing reasons, the decision of the district court is

Affirmed.

SENTELLE, Circuit Judge, dissenting in part:

While I concur with much of the majority's opinion, insofar as it holds constitutional the twenty-year or more extension of copyright protection for existing works, I dissent. This issue calls upon us to consider the scope of one of the clauses granting enumerated powers to Congress, specifically, Art. I, § 8, cl. 8:

> Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries. . . .

In ascertaining the breadth of an enumerated power, I would follow the lead of the United States Supreme Court in *United States v. Lopez*, 514 U.S. 549, 552 (1995), and "start with first principles." The governing first principle in *Lopez* and in the matter before us is that "[t]he Constitution creates a Federal Government of enumerated powers." 514 U.S. at 552 (citing Art. I, § 8). The Framers of the Constitution adopted the system of limited central government "to ensure the protection of our fundamental liberties." *Gregory v. Ashcroft*, 501 U.S. 452, 458 (1991) (internal quotations and citations omitted). The *Lopez* decision, considering the validity of the so-called

Gun-Free School Zones Act, reminded us that "congressional power under the Commerce Clause . . . is subject to outer limits." 514 U.S. at 556-57; *see also United States v. Morrison*, 529 U.S. 598, 120 S. Ct. 1740, 1748-49 (2000).

It would seem to me apparent that this concept of "outer limits" to enumerated powers applies not only to the Commerce Clause but to *all* the enumerated powers, including the Copyright Clause, which we consider today. In determining whether the legislation before it in such cases as *Lopez* exceeded the outer limit of the authority granted under the Commerce Clause, the *Lopez* Court laid out a precise outline concededly not applicable by its terms to the construction of other clauses, but I think most useful in conducting the same sort of examination of the outer limits of any enumerated power. As a part of that analysis, the Court examined the extension of congressional authority to areas beyond the core of the enumerated power with a goal of determining whether the rationale offered in support of such an extension has any stopping point or whether it would lead to the regulation of all human activity. *See* 514 U.S. at 564 ("Thus, if we were to accept the Government's arguments, we are hard pressed to posit any activity by an individual that Congress is without power to regulate."). I fear that the rationale offered by the government for the copyright extension, as accepted by the district court and the majority, leads to such an unlimited view of the copyright power as the Supreme Court rejected with reference to the Commerce Clause in *Lopez*.

What then do I see as the appropriate standard for limiting that power? Again, the *Lopez* decision gives us guidance as to the application of first principles to the determination of the limits of an enumerated power. Citing *Gibbons v. Ogden*, 22 U.S. (9 Wheat.) 1, 189-190 (1824), the *Lopez* Court acknowledged "that limitations on the commerce power are inherent in the very language of the Commerce Clause." 514 U.S. at 553.

Just so with the Copyright Clause. What does the clause empower the Congress to do?

> To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries. . . .

That clause empowers the Congress to do one thing, and one thing only. That one thing is "to promote the progress of science and useful arts." How may Congress do that? "By securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." The clause is not an open grant of power to secure exclusive rights. It is a grant of a power to promote progress. The means by which that power is to be exercised is certainly the granting of exclusive rights—not an elastic and open-ended use of that means, but only a securing for limited times. *See Stewart v. Abend*, 495 U.S. 207, 228 (1990) ("The copyright term is limited so that the public will not be permanently deprived of the fruits of an artist's labors."). The majority acknowledges that "[i]f the Congress were to make copyright protection permanent, then it surely would exceed the power conferred upon it by the Copyright Clause." Maj. Op. at 377. However, there is no apparent substantive distinction between permanent protection and permanently available authority to extend originally limited protection. The Congress that can extend the protection of an existing work from 100 years to 120 years, can extend that protection from 120 years to 140; and from 140 to 200; and from 200 to 300; and in effect can accomplish precisely what the majority admits it cannot do directly. This, in my view, exceeds the proper understanding of enumerated powers reflected in the *Lopez* principle of requiring some definable stopping point.

Returning to the language of the clause itself, it is impossible that the Framers of the Constitution contemplated permanent protection, either directly obtained or attained through the

guise of progressive extension of existing copyrights. The power granted by the clause again is the power "to promote the progress of science and useful arts." As stated above, Congress is empowered to accomplish this by securing for limited times exclusive rights. Extending existing copyrights is not promoting useful arts, nor is it securing exclusivity for a limited time.

The government has offered no tenable theory as to how retrospective extension can promote the useful arts. As the Supreme Court noted in *Lopez* and again in *United States v. Morrison*, that Congress concluded a given piece of legislation serves a constitutional purpose "does not necessarily make it so." *Lopez*, 514 U.S. at 557 n.2 (internal quotes omitted); *Morrison*, 120 S. Ct. at 1752. Pressed at oral argument, counsel for the government referred to keeping the promise made in the original grant of exclusivity for a limited time. The easy answer to this assertion is that Congress is not empowered to "make or keep promises" but only to do those things enumerated in Article I. The second problem with the government's assertion is that Congress made no promise to commit such an extension but only to secure the exclusive rights for the original limited period. Thirdly, the means employed by Congress here are not the securing of the exclusive rights for a limited period, but rather are a different animal altogether: the extension of exclusivity previously secured. This is not within the means authorized by the Copyright Clause, and it is not constitutional.

The majority responds to this problem of the statute's exceeding the constitutional grant by reliance on *Schnapper v. Foley*, 667 F.2d 102 (D.C. Cir. 1981), "in which we rejected the argument 'that the introductory language of the Copyright Clause constitutes a limit on congressional power.'" Maj. Op. at 378 (quoting 667 F.2d at 112). I will concede that it does not matter if I disagree with the language of *Schnapper* (which in fact I do) as it is our Circuit precedent and we are bound by its holding unless and until that holding is changed by this court

en banc or by the higher authority of the Supreme Court. *See, e.g., LaShawn A. v. Barry*, 87 F.3d 1389, 1395 (D.C. Cir. 1996) (en banc) ("One three-judge panel . . . does not have the authority to overrule another three judge panel of the court. That power may be exercised only by the full court." (citations omitted)); *United States v. Kolter*, 71 F.3d 425, 431 (D.C. Cir. 1995) ("This panel would be bound by [a prior] decision even if we did not agree with it.").

Therefore, it is immaterial that the prior opinion is, in my view, erroneous in styling the granting clause of the sentence as merely introductory when in fact it is the definition of the power bestowed by that clause. Thus, unless and until this precedent is wiped away, if *Schnapper* has held that we may not look to the language of this phrase to determine the limitations of the clause then I must concede that we are bound by that holding and join the majority's result. However, it does not appear to me that this is the holding of *Schnapper*. The *Schnapper* Court dealt with limited questions related to the application of the copyright laws to works commissioned by the U.S. government. In answering those questions, the *Schnapper* Court held that "Congress need not 'require that each copyrighted work be shown to promote the useful arts.' "667 F.2d at 112 (quoting *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 860 (5th Cir. 1979)). It was in that context that the *Schnapper* Court employed the wording relied upon by the majority concerning the "introductory language" of the Copyright Clause. Insofar as that wording is taken to be anything more than the determination concerning that limited analysis, it is not a holding but simply *dicta* (perhaps *obiter dicta)* and not binding on future panels.

Rather, the *Schnapper* analysis again takes us back to the *Lopez* approach to judicial interpretation of the enumerated powers clauses. In *Lopez*, one of the means employed to determine the constitutionality of extended application of the Commerce Clause is an elemental inquiry into whether in each

case the purportedly regulated action "in question affects interstate commerce." 514 U.S. at 561. However, the jurisdictional element is not necessary under *Lopez* analysis of Commerce Clause regulation where Congress is directly regulating "the use of the channels of interstate commerce" or "persons or things in interstate commerce." *Id.* at 558. Similarly, I suggest that in analyzing the extent of congressional power under the Copyright Clause, the *Schnapper* holding that each individual application of copyright protection need not promote the progress of science and the useful arts does not mean that Congress's power is otherwise unlimited, anymore than the lack of a necessity for case-by-case analysis of the effect on interstate commerce validates anything Congress may wish to do under the rubric of the Commerce Clause. Though, under *Schnapper*, we may not require that each use of a copyright protection promote science and the arts, we can require that the exercise of power under which those applications occur meet the language of the clause which grants the Congress the power to enact the statute in the first place. This the extension does not do. It is not within the enumerated power.

The majority suggests that my reading of *Schnapper* is somehow foreclosed by the fact that it accepts the argument of an amicus. *See* Maj. Op. at 378 (citing 16A CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 3975.1 & n.3 (3d ed.1999); *Resident Council of Allen Parkway Vill. v. HUD*, 980 F.2d 1043, 1049 (5th Cir. 1993)). The disposition I suggest would offend nothing in either Professor Wright's treatise or the cases aligned with it. Neither I nor the amicus raise any issue not raised by the parties to the case, nor disposed of by a majority of the court. Appellants raise the issue "whether . . . the Copyright Clause of the Constitution of the United States constrains the Congress from extending for a period of years the duration of copyrights, both those *already extant* and those yet to come." Maj. Op. at 373 (emphasis added). The majority addresses that issue and holds

against the appellant. Maj. Op. at 380 ("we hold that the CTEA is a proper exercise of the Congress's power under the Copyright Clause"). That the amicus argues more convincingly in appellants' favor on the issue raised by the appellants than they do themselves is no reason to reject the argument of the amicus. Indeed, our Circuit Rules provide that an amicus brief "must avoid repetition of facts or legal arguments made in the principal (appellant/petitioner or appellee/respondent) brief and focus on points not made or adequately elaborated upon in the principal brief, although relevant to the issues before this court." Circuit Rule 29. Obviously that is precisely what the amicus has done in this case.

Resident Council of Allen Parkway Village, relied on by the majority, highlights this difference between introducing issues not raised by the parties on the one hand and making new arguments for issues otherwise properly raised on the other. As the Fifth Circuit noted in that case, "[w]e are constrained only by the rule that an amicus curiae generally cannot expand the scope of an appeal to implicate *issues* that have not been presented by the parties to the appeal." 980 F.2d at 1049 (emphasis added).

Our Circuit Rule and the Fifth Circuit are in good company in allowing amici to make additional arguments that address issues which the parties have raised but not argued in the same fashion. The Supreme Court has approved precisely that approach. In *Teague v. Lane*, 489 U.S. 288 (1989), that Court considered a question of retroactivity as to a fair cross section jury venire in a case also raising a claim under *Batson v. Kentucky*, 476 U.S. 79 (1986). The Court noted that "[t]he question of retroactivity with regard to petitioner's fair cross section claim has been raised only in an *amicus* brief." 489 U.S. at 300. Noting that the "question is not foreign to the parties, who have addressed retroactivity with respect to petitioner's *Batson* claim," *id.*, the Court proceeded to address the merits of the argument.

Nor are we constrained by the parties' apparent agreement as to the state of the law under *Schnapper*. The Supreme Court has made it clear that we cannot be bound by stipulations of law between the parties, where there is "a real case and controversy extending to that issue." *United States Nat'l Bank of Or. v. Indep. Ins. Agents of Am., Inc.*, 508 U.S. 439, 446 (1993). As the High Court put it, "'[w]hen an issue or claim is properly before the court, the court is not limited to the particular legal theories advanced by the parties, but rather retains the independent power to identify and apply the proper construction of governing law.'" *Id.* (quoting *Kamen v. Kemper Fin. Servs., Inc.*, 500 U.S. 90, 99 (1991)).

I find two other arguments the majority invokes against my dissent unpersuasive. The enactment by the first Congress in 1790 regularizing the state of copyright law with respect to works protected by state acts preexisting the Constitution appears to me to be *sui generis*. Necessarily, something had to be done to begin the operation of federal law under the new federal Constitution. The Act of May 31, 1790, 1 Stat. 124, created the first (and for many decades only) federal copyright protection; it did not *extend* subsisting *federal* copyrights enacted pursuant to the Constitution. *Cf. Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 661 (1834) ("Congress, then, by this [copyright] act, instead of sanctioning an existing right, as contended for, created it."). The fact that the CTEA "matches United States copyrights to the terms of copyrights granted by the European Union," Maj. Op. at 379 (citing Council Directive 93/98, art. 7, 1993 O.J. (L 290) 9), is immaterial to the question. Neither the European Union nor its constituent nation states are bound by the Constitution of the United States. That Union may have all sorts of laws about copyrights or any other subject which are beyond the power of our constitutionally defined central government.

Therefore, I respectfully dissent.

255 F.3d 849

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT.

Eric ELDRED, et al., Appellants,
v.
John ASHCROFT, In his official capacity as Attorney General, Appellee.

No. 99-5430.

Filed July 13, 2001.

On Petition for Rehearing.

Before: GINSBURG, SENTELLE and HENDERSON, Circuit Judges.

Opinion for the Court filed by Circuit Judge GINSBURG.[1]

GINSBURG, Circuit Judge:

The plaintiffs-appellants in this case, corporations, associations, and individuals who rely for their vocations and avocations upon works in the public domain, have petitioned for rehearing and filed a suggestion for rehearing en banc. They renew their contentions that the Copyright Term Extension Act of 1998 (CTEA), Pub. L. No. 105-298, 112 Stat. 2827, violates both the First Amendment and the Copyright Clause of the Constitution of the United States.

The plaintiffs-appellants further complain that this court erred in its treatment of the contentions advanced by one of the amici. We are not persuaded. The district court's rejection of the plaintiffs-appellants' constitutional attack followed from its

[1] Circuit Judge SENTELLE dissents from the denial of rehearing.

conclusion, in the light of our decision in *Schnapper v. Foley*, 667 F.2d 102, 112 (1981), that "[t]he introductory language of the copyright clause does not limit [the Congress's] power." Upon appeal, the plaintiffs-appellants did not challenge that determination; rather, they maintained only that the substantive grant of power in the Copyright Clause—authorizing the Congress to grant copyrights for "limited Times"—does not authorize the Congress to extend the terms of copyrights as it did in the CTEA. In sharp contrast, an amicus contended that the CTEA violates the preamble to the Copyright Clause because extending the term of a subsisting copyright does not "promote the Progress of Science and useful Arts."

As we stated in Part III of our opinion, 239 F.3d 372, 378 (2001), the court deems it "particularly inappropriate" in this case to reach the merits of the amicus's position. To elaborate: First, in their brief the plaintiffs-appellants themselves took the position, diametrically opposed to that of the amicus, "that the preamble of the Copyright Clause is not a substantive limit on Congress' legislative power"; when expressly offered the opportunity at oral argument to adopt the position of the amicus, the plaintiffs-appellants did not do so. Therefore, even if we were to read the plaintiffs-appellants' brief broadly as raising the issue whether the Copyright Clause as a whole—including both the preamble and the grant of authority—renders the CTEA unconstitutional, following the lead of the Supreme Court we would still not reach what would then be the supporting argument of the amicus. *See New Jersey v. New York*, 523 U.S. 767, 781 n.3 (1998) (although arguments of amici and party stem from same article of compact, court "must pass over the arguments of the named *amici* for the reason that . . . the party to the case[ ] has in effect renounced them, or at least any benefit they might provide"); *see also Amax Land Co. v. Quarterman*, 181 F.3d 1356, 1367 (D.C. Cir. 1999) (remanding where the parties "request[ed] us to remand to the district court for consideration of [legal] issue," whereas "the amicus'

prefer[red] that we resolve it" ourselves, which we could readily have done); *Narragansett Indian Tribe v. Nat'l Indian Gaming Comm'n*, 158 F.3d 1335, 1338 (D.C. Cir. 1998) ("Because we ordinarily do not entertain arguments not raised by parties . . . we consider only the [party's] equal protection challenge" where amicus filed brief "supporting [party's] equal protection claim and reiterating its separation of powers and bill of attainder arguments"); *Michel v. Anderson*, 14 F.3d 623, 625 (D.C. Cir. 1994) (court ordinarily "would not entertain an *amicus'* argument if not presented by a party").

Second, the point advanced by the amicus—that the preamble of the Copyright Clause is a substantive limitation upon the power of the Congress—implicates discrete terms of the Clause that are not otherwise at issue. In that sense it poses an additional constitutional question, subject to the "rule of avoidance"; and there can hardly be a better reason to avoid a constitutional question than that the parties are in agreement. *See, e.g., Ashwander v. Tennessee Valley Authority*, 297 U.S. 288, 346 (1936) (Brandeis, J., concurring) ("Court will not 'anticipate a question of constitutional law in advance of the necessity of deciding it' ").

Third, because the plaintiffs-appellants did not take the same tack as the amicus, the Government did not on brief address the district court's interpretation of this court's decision in *Schnapper*. *See New Jersey v. New York*, 523 U.S. at 781 n.3. Therefore, our usual concern with "avoid[ing] unnecessary or premature constitutional rulings," here as in *Harmon v. Thornburgh*, 878 F.2d 484, 494 (D.C. Cir. 1989), "is heightened by the absence of meaningful argument by the parties on this question."

Finally, as explained in Part III of the opinion, *id.* at 378-80, even if we considered the amicus's position we would not reach a different result in this case: Regardless whether, as the amicus contends, the preamble limits the power of the Congress, the CTEA still passes muster under the "necessary

and proper review" applicable to the Congress's "exercise of a power enumerated in Article I." 239 F.3d at 378. The Congress found that extending the duration of copyrights on existing works would, among other things, give copyright holders an incentive to preserve older works, particularly motion pictures in need of restoration. *Id.* at 379. "Preserving access to works that would otherwise disappear—not enter the public domain but disappear—'promotes Progress' as surely as does stimulating the creation of new works." *Id.*

We reject the plaintiffs-appellants' challenge under the First Amendment for the reasons stated in the prior opinion. Accordingly, the petition for rehearing is

Denied.

BEFORE: EDWARDS, Chief Judge, WILLIAMS, GINSBURG, SENTELLE, HENDERSON, RANDOLPH, ROGERS, TATEL, and GARLAND, Circuit Judges.

ORDER

PER CURIAM

Appellants' petition for rehearing en banc and the response thereto have been circulated to the full court. The taking of a vote was requested. Thereafter, a majority of the judges of the court in regular active service did not vote in favor of the petition. Upon consideration of the foregoing, it is

ORDERED that the petition be denied.

A statement of Circuit Judge SENTELLE, joined by Circuit Judge TATEL, dissenting from the denial of rehearing en banc is attached.

SENTELLE, Circuit Judge, *dissenting from the denial of rehearing en banc,* with whom Circuit Judge TATEL joins:

In my view, the decision in this case is not only incorrect, but is worthy of en banc review on both circuit-specific procedural grounds and fundamental constitutional grounds.

First, procedurally, the Court's opinion in this case effectively eliminates any role for *amicus curiae* in the practice of this circuit, when it holds that an argument raised by an *amicus* may not be considered by the Court. *See Eldred v. Reno,* 239 F.3d 372, 378 (D.C. Cir. 2001). There is no dispute that an *amicus curiae* may not raise new *issues* in an appeal. Rather, the role of an *amicus* is to assist the court in addressing the issues already raised with new arguments and perspectives. In this case, the *issue* before the Court was, in the panel's words, "whether . . . the Copyright Clause of the Constitution of the United States constrains the Congress from extending for a period of years the duration of copyrights, both those already extant and those yet to come." *Eldred,* 239 F.3d at 373. The *amicus* brief submitted on behalf of Eagle Forum addressed this issue more persuasively than did appellants. But *amicus* did not "expand the scope" of the appeal by "implicat[ing] issues" not raised by the appellant. *See Resident Council of Allen Parkway Vill. v. HUD,* 980 F.2d 1043, 1049 (5th Cir.1993) ("We are constrained *only* by the rule that an amicus curiae generally cannot expand the scope of an appeal to implicate *issues* that have not been presented by the parties to the appeal." (emphases added)). Rather, as the majority noted, *amicus* adopted a different "argument." *Eldred,* 239 F.3d at 378. A new "argument" is not a new "issue." This is clear from our circuit's rules. Specifically, an *amicus* brief "must avoid repetition of facts or legal arguments made in the principal (appellant/petitioner or appellee/respondent) brief and focus on points not made or adequately elaborated upon in the principal brief, although relevant to the issues before this court." Circuit Rule 29. The role of *amici* is to help in this

process, by elaborating upon arguments made by the parties *and* presenting arguments of their own that bear upon the issues raised by the parties themselves. *See White v. Illinois,* 502 U.S. 346, 352 (1992) ("We consider as a preliminary matter an argument not considered below but urged by the United States as *amicus curiae* in support of respondent.").

"When an issue or claim is properly before the court, the court is not limited to the particular legal theories advanced by the parties, but rather retains the independent power to identify and apply the proper construction of governing law." *Kamen v. Kemper Fin. Servs., Inc.,* 500 U.S. 90, 99 (1991); *see also United States Nat'l Bank of Oregon v. Indep. Ins. Agents of Am. Inc.,* 508 U.S. 439, 446 (1993) (same). Merely because the parties fail to advance the proper legal theory underlying their claim does not—indeed cannot—prevent a court from arriving at the proper legal disposition. Once the issue is raised, a court has an obligation to determine what the law is which will govern the case at hand. This is so irrespective of whether *amici curiae* enter an appearance. As it happened, Eagle Forum submitted an *amicus curiae* brief augmenting appellants' position by making a different argument on the issue before the Court, and at least one member of the panel found it persuasive. Even if the majority did not find *amicus's* argument compelling, it was properly before the Court.

The majority holds that the "argument" raised by one *amicus* was "not properly before" this Court because it was effectively renounced by appellants. *Eldred,* 239 F.3d at 378. This claim is not supported by the record. The relevant *amicus* brief was submitted some two weeks *after* appellants' opening brief. Insofar as the oral argument transcript shows anything at all, it illustrates that appellants had not explicitly adopted *amicus's*

arguments in brief but had no problem taking advantage of *amicus's* argument.[2]

The language of *New Jersey v. New York*, 523 U.S. 767, 781 n.3 (1998), might be taken to suggest that a court must "pass over . . . arguments" raised only by an *amicus*, but I believe that this is a misreading of the case. In *New Jersey*, the Court noted that only *amici* took issue with the special master's conclusion affirming the Court's prior holding that "the 'boundary line' between the States established in Article First [of the Interstate Compact]" was the line of sovereignty between the states. *Id.* at 781. In other words, the *amici*, and only the *amici*, sought to overturn Supreme Court precedent. Additionally, insofar as the *amici* sought to make an exception to the special master's finding with regard to Article First of the compact, it sought to obtain the Court's judgment about a matter about which there was no present controversy. *See United States v. Louisiana*, 446 U.S. 253, 260-61 (special master's recommendation not subject to exception by either party accepted by Court due to lack of "present controversy"), *reh'g denied*, 447 U.S. 930 (1980). Thus, even though the Court used the word "argument" to characterize the claims put forward by *amici*, they were raising issues beyond the purview of the case before the Court.

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[2] The relevant portion of the transcript reads as follows:

> THE COURT: Have you adopted any point—any arguments that appear in any of these amicus briefs? Or maybe—I don't remember—there is more than one, but in any brief other than your own? LESSIG: Well, in particular, Mr. Jaffe's brief is a brief that makes textualist arguments that we believe are quite strong in this way.
>
> THE COURT: Is there any place in which you have adopted them, in your briefs?
>
> LESSIG: We formally acknowledge them in our briefs. I don't believe we have, Your Honor, no.

Contrary to the suggestion of the panel majority, appellants' argument did implicate the "preamble" of the Copyright Clause, just not in the same fashion as *amicus*. Appellants stipulated to the reading postulated by the district court, as the panel majority notes. Appellants' Opening Brief at 29 n.15. Yet in the very footnote cited by the panel majority, appellants claimed that the remaining portions of the Copyright Clause must be read "in light of th[e] preamble." *Id.* Contrary to my colleagues' suggestion, this Court was not asked to "anticipate" a question of constitutional law, but to decide a very discreet question—whether the CTEA exceeds the grant of power in the Copyright Clause. Whether appellants asked this Court to recognize that the so-called "preamble" is in fact the enumerated power, or merely to read the rest of the clause "in light of that preamble" should be immaterial. Indeed, the Supreme Court noted long ago that the words of the Copyright Clause should be read "with the words and sentences with which it stands connected." *Wheaton v. Peters*, 33 U.S. (8 Peters) 591, 661 (1834); *see also Postmaster-General v. Early*, 25 U.S. (12 Wheat.) 136, 152 (1827) (it is a "cardinal rule of construction" that "the whole law is to be taken together, and one part expounded by any other which may indicate the meaning annexed . . . to ambiguous phrases").

Under the panel's holding, it is now the law of this circuit that *amici* are precluded *both* from raising new issues *and* from raising new arguments. If allowed to stand, this holding will effectively bar future *amici* from adding anything except possibly rhetorical flourish to arguments already outlined and embraced by the parties. This is particularly the case for those *amici* who, true to their traditional role as "friends of the court," operate independently to assist the Court in its determinations. If this Court is to adopt such a rule—and I hope we do not—we should do so sitting en banc, not by a divided panel.

Second, and more importantly, the Court's construction of the Copyright Clause of the Constitution renders Congress's power under Art. I, § 8, cl. 8, limitless despite express limitations in the terms of that clause. The clause grants to Congress the "power . . . [t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries. . . ." Under the Court's decision herein, Congress may at or before the end of each such "limited period" enact a new extension, apparently without limitation. As the majority conceded, "[i]f the Congress were to make copyright protection permanent, then it surely would exceed the power conferred upon it by the Copyright Clause." *Eldred*, 239 F.3d at 377. The majority never explained how a precedent that would permit the perpetuation of protection in increments is somehow more constitutional than one which did it in one fell swoop. As the majority noted in describing my panel dissent, "Judge Sentelle . . . sees a categorical distinction between extending the term of a subsisting copyright and extending that of a prospective copyright." *Id.* at 379, 239 F.3d 372. Indeed I do. Establishing the term of a prospective copyright is not an extension, nor does it in itself implicate the authority of Congress to incrementally create perpetual exclusivity.

Contrary to my colleagues, I do not accept that it is sufficient for Congress to merely articulate some hypothetical basis to justify the claimed exercise of an enumerated power. The Copyright Clause only bestows the power 'to promote the progress of science and useful arts." In exercising this power, Congress "may not overreach the restraints imposed by the stated constitutional purpose," which is "the promotion of advances in the 'useful arts.'" *Graham v. John Deere Co.*, 383 U.S. 1, 5, 6 (1966). I accept that extending copyright terms for future works may well increase creative efforts at the margin. Once a work is published, however, extending the copyright term does absolutely nothing to induce further creative activity by the author—and how could it? The work

is already published. A simple finding by Congress to the contrary is not sufficient to demonstrate that the exercise of that power is "necessary and proper." As the Supreme Court noted in *Lopez* and again in *Morrison*, that Congress concluded a given piece of legislation serves a Constitutional purpose "does not necessarily make it so." *United States v. Lopez*, 514 U.S. 549, 557 n.2 (1995) (citation omitted); *United States v. Morrison*, 529 U.S. 598 (2000).

The panel concluded—wrongly in my view, *see Eldred*, 239 F.3d at 382-83 (Sentelle, J., dissenting)—that my interpretation of the Copyright Clause is precluded by *Schnapper v. Foley*, 667 F.2d 102 (D.C. Cir. 1981), which appeared to reject any meaningful limit on the scope of the copyright power. This interpretation of *Schnapper* erases from Article I half of the Copyright Clause—indeed, that half which defines the very power bestowed. If *Schnapper* indeed precludes a panel of this Court from applying the Constitution as written, then we have yet one more reason to consider this case en banc.

The majority opinion in this case dramatically narrowed the role of *amici* before this Court and, in my view, effectively erased portions of the Copyright Clause of the Constitution. Though I believe that this Court should grant en banc review quite sparingly, either issue individually merits en banc review. Because this case presents both questions, it is particularly worthy of the full Court's attention.

74 F. Supp. 2d 1

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA.

Eric ELDRED, et al., Plaintiffs,
v.
Janet RENO, In her official capacity as Attorney General of the United States, Defendant.

No. 99-0065 (JLG).

Oct. 28, 1999.

MEMORANDUM

JUNE L. GREEN, District Judge.

Before the Court are the parties' cross-motions for Judgement on the Pleadings pursuant to Fed. R. Civ. P. 12(c), and the responses and replies thereto.[1] Pursuant to 28 U.S.C. § 2201 the Plaintiffs seek a declaratory judgment that Section 102(d)(1)(B) of the Sonny Bono Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 ("CTEA"), amending 17 U.S.C. § 304(b), is unconstitutional.[2]

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[1] *Amici Curiae* filed briefs in support of the Defendant.

[2] They also seek, upon the courts finding that the CTEA is unconstitutional, a preliminary and permanent injunctive relief against the criminal enforcement of Section 2(b) of the No Electronic Theft Act of 1997, with respect to works that would not have a valid copyright but for the enactment of Section 102(d)(1)(B) of the CTEA. *See* Publ. L. No. 105-147, 111 Stat. 2678 ("Net Act"), amending 17 U.S.C. § 506(a). As the court denies the declaratory judgment, it also denies the injunctive relief requested.

For the reasons that follow, the court concludes that the CTEA is not unconstitutional. Accordingly, the Court denies the declaratory judgment requested. As explained more fully below, the Defendant's motion for Judgment on the Pleadings is granted.

I. BACKGROUND

The Plaintiffs are Eric Eldred, Eldritch Press, Higginson Book Company, Jill A. Crandall, Tri-Horn International, Luck's Music Library, Inc., Edwin F. Kalmus Co., American Film Heritage Association, Moviecraft, Inc., Dover Publications, Inc., and Copyright's Commons. They allege that they each use, copy, reprint, perform, enhance, restore or sell works of art, film, or literature in the public domain. (Second Am. Compl. at 4.) They further allege that they prepared to use in some way works created before 1923 and but for the CTEA they could have legally copied, distributed, or performed these works that would otherwise have entered the public domain. (Second Am. Compl. at 4.)[3]

The Constitution provides that Congress has the power "[t]o promote the [p]rogress of [s]cience and useful [a]rts, by securing for limited [t]imes to [a]uthors and [i]nvestors the exclusive [r]ight to theirrespective [w]ritings and [d]iscoveries." U.S. Const. art. I, § 8, cl. 8. In 1970, pursuant to this power, Congress enacted a federal copyright statute

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[3] The Defendant does not deny these allegations or raise standing in any filing. (Ans. Second Am. Compl. at 2.) Unless the Plaintiffs' allegation that they prepared to use these works in some way is untrue, the Plaintiffs have constitutional standing as the enactment of the CTEA allegedly caused an injury in fact to their ability to use these works that is redressable by declaratory judgment. *See, e.g., Federal Election Commission v. Akins*, 524 U.S. 11 (1998).

providing for exclusive rights for limited times.[4] Since then, Congress revised and extended these exclusive rights for limited times.[5]

The latest revision and extension, the CTEA, became law on October 27, 1998. Sonny Bono Copyright Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827. The CTEA provides for exclusive rights for the life of the author plus 70 years (or for certain works, if the life of the author cannot be ascertained, for 95 years after publication or 120 years after the creation of the work, whichever is shorter). These rights apply to works created on or after January 1, 1978, and works created before then with existing rights subsisting in a renewal term provided by the Copyright Act of 1976.

Plaintiffs allege that the CTEA violates the first amendment. Pls' Mem. at 35-58, 69-87.

They also allege that the retrospective extension of copyright protections beyond Congress's enumerated power under the copyright clause and violates the public interest doctrine. Pls.' Mem. at 23-35, 58-69.

II. Analysis

A. First Amendment Rights

The Plaintiffs' first claim, that the CTEA violates the First Amendment, is not supported by relevant case law. Pls.' Mem.

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[4] The original statute provided a copyright for fourteen years and additional fourteen years if the author was living U.S. citizen. Act of May 31, 1790, §§ 1 and 3, 1 Stat. 124-25.

[5] *See* Act of Feb. 3, 1831, ch. 16, § 2, 4 Stat. 436; Act of March 4, 1909; ch. 320 § 23, 35 Stat. 1075, 1080; Act of Oct. 19, 1976, §§ 302, 303, Pub. L. No. 94-553, 90 Stat. 2598; see also Pub. L. No. 87-668 (1962); Pub. L. No. 89-142 (1965); Pub. L. No. 90-141 (1967); Pub. L. No. 90-416 (1968); Pub. L. No. 91-147 (1969); Pub. L. No. 92-170 (1971); Pub. L. No. 92-566 (1972); Pub. L. No. 93-573 (1974).

at 35-58, 69-87. The District of Columbia Circuit has ruled definitively that there are no First Amendment rights to use the copyrighted works of others. *United Video v. F.C.C.*, 890 F.2d 1173, 1191 (D.C. Cir. 1989); *see Harper & Row, Publishers, Inc. v. National Enterprises*, 471 U.S. 539, 556 (1985). Therefore, the Court rejects Plaintiffs' First Amendment claim.

B. Retrospective Extension

1. Enumerated Power

The Plaintiffs next allege that the retrospective extension of copyright protection is beyond Congress's enumerate power under the copyright clause. Pls.' Mem. at 23-35. They allege that the retrospective extension violates the "[l]imted [t]imes" and the "to [a]uthors" terms of the copyright clause. Pls.' Mem. at 23-28.

First, they allege that by changing, on several occasions, the limited times for some copyright grants, the Defendant violated the 'l]imited [t]imes" clause. Pls.' Mem. at 28-33. The Supreme Court has held that Congress defines the scope of the grant of copyrights to authors or to inventors under its copyright clause power.[6] *Sony Corporation of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984). The "[l]imited [t]imes" period is "subject to discretion of Congress." *Pennock & Sellers v. Dialogue*, 27 U.S. (2 Pet.) 1, 16-17 (1829). Moreover, Congress has authority to enact retrospective laws under the copyright clause[7] *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 206 (1843). In light of

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[6] The introductory language of the copyright clause does not limit this power. *Schnapper v. Foley*, 667 F.2d 102, 112 (D.C. Cir. 1981).

[7] Within the discretion of Congress, any fixed term is a limited time because it is not perpetual. If a limited time is extended for a limited time then it remains a limited time.

these decisions, the Court concludes that the CTEA's extension of limited times is within the discretion of Congress.

Second the Plaintiffs allege that the retrospective extension violates the "to [a]uthors" term of the copyright clause.[8] Pls.' Mem. At 33-35. Under the CTEA, if, prior to its enactment, the author agreed in advance to assign rights under the CTEA's extended term, then such an agreement is given effect because there is no contrary presumption that the grant of extended term not be so assigned. 17 U.S.C. §§ 203, 304(c) and 304(d) Although the Plaintiffs allege that the absence of such a presumption violates the "to [a]uthors" term, it does not. The author may agree to transfer his or her exclusive rights to a third party only for a limited period or, alternatively, subject to any applicable statutory termination right, the author may agree in advance (before a renewal period or term extension commences) to transfer or assign future copyrights conferred upon that author by Congress. *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643 (1943).

2. Public Trust Doctrine

Lastly, Plaintiffs allege that the retroactive extension of copyright protection violates the public trust doctrine. Pls.' Mem. at 58-69. Under the doctrine, the states hold title to navigable and tidal waters within their boundaries in trust for their people. *See, e.g., Phillips Petroleum Co. v. Mississippi*, 484 U.S. 469, 473-81 (1988); *District of Columbia v. Air Florida, Inc.*, 750 F.2d 1077, 1082-83 (D.C. Cir. 1984). Insofar as the public trust doctrine applies to navigable waters and not copyrights, the retroactive extension of copyright protection does not violate the public trust doctrine.

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[8] Congress has the power "[t]o promote the [p]rogress of [s]cience and useful [a]rts, by securing for limited [t]imes to [a]uthors and [i]nventors the exclusive [r]ight to their respective [w]riting and [d]iscoveries." U.S. Const. art. I, § 8, cl. 8.

III. CONCLUSION

For reason set forth above, the Defendant's motion for Judgment on the Pleadings, pursuant to Fed. R. Civ. P. 12(c) is granted. An appropriate Order accompanies this Memorandum.

ORDER

Upon consideration of the parties cross-motions for Judgment on the Pleadings under Fed. R. Civ. P. 12(c), the responses and replies thereto, and for the reasons stated in the accompanying memorandum of law, it is by the Court this 27th day of October 1999,

ORDERED that the Plaintiffs' motion for Judgment on the Pleadings is DENIED; it is further

ORDERED that the Defendant's motion for Judgment on the Pleadings is **GRANTED**.

17 U.S.C. § 302

UNITED STATES CODE ANNOTATED
TITLE 17. COPYRIGHTS
CHAPTER 3—DURATION OF COPYRIGHT

§ 302. Duration of copyright: Works created on or after January 1, 1978

(a) In General.—Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and 70 years after the author's death.

(b) Joint Works.—In the case of a joint work prepared by two or more authors who did not work for hire, the copyright endures for a term consisting of the life of the last surviving author and 70 years after such last surviving author's death.

(c) Anonymous Works, Pseudonymous Works, and Works Made for Hire.—In the case of an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 95 years from the year of its first publication, or a term of 120 years from the year of its creation, whichever expires first. If, before the end of such term, the identity of one or more of the authors of an anonymous or pseudonymous work is revealed in the records of a registration made for that work under subsections (a) or (d) of section 408, or in the records provided by this subsection, the copyright in the work endures for the term specified by subsection (a) or (b), based on the life of the author or authors whose identity has been revealed. Any person having an interest in the copyright in an anonymous or pseudonymous work may at any time record, in records to be maintained by the Copyright Office for that purpose, a statement identifying one or more authors of the work; the statement shall also identify the person filing it, the nature of

that person's interest, the source of the information recorded, and the particular work affected, and shall comply in form and content with requirements that the Register of Copyrights shall prescribe by regulation.

(d) Records Relating to Death of Authors.—Any person having an interest in a copyright may at any time record in the Copyright Office a statement of the date of death of the author of the copyrighted work, or a statement that the author is still living on a particular date. The statement shall identify the person filing it, the nature of that person's interest, and the source of the information recorded, and shall comply in form and content with requirements that the Register of Copyrights shall prescribe by regulation. The Register shall maintain current records of information relating to the death of authors of copyrighted works, based on such recorded statements and, to the extent the Register considers practicable, on data contained in any of the records of the Copyright Office or in other reference sources.

(e) Presumption as to Author's Death.—After a period of 95 years from the year of first publication of a work, or a period of 120 years from the year of its creation, whichever expires first, any person who obtains from the Copyright Office a certified report that the records provided by subsection (d) disclose nothing to indicate that the author of the work is living, or died less than 70 years before, is entitled to the benefit of a presumption that the author has been dead for at least 70 years. Reliance in good faith upon this pre-sumption shall be a complete defense to any action for infringement under this title.

76 Stat. 555
Public Law 87-668
September 19, 1962
[H.J. Res. 627]

JOINT RESOLUTION

Extending the duration of copyright protection in certain cases.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution would expire prior to December 31, 1965, such term is hereby continued until December 31, 1965.

Approved September 19, 1962.

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79 Stat. 581
Public Law 89-142
August 28, 1965
[H.J. Res. 431]

JOINT RESOLUTION

Extending the duration of copyright protection in certain cases.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution, or the term thereof as extended by Public Law 87-668, would expire prior to December 31, 1967, such term is hereby continued until December 31, 1967.

Approved August 28, 1965.

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81 Stat. 464
Public Law 90-141
November 16, 1967
[S.J. Res. 114]

JOINT RESOLUTION

Extending the duration of copyright protection in certain cases.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution, or the term thereof as extended by Public Law 87-668, or by Public Law 89-142 (or by either or bother of said laws), would expire prior to December 31, 1968, such term is hereby continued until December 31, 1968.

Approved November 16, 1967.

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82 Stat. 397
Public Law 90-416
July 23, 1968
[S.J. Res. 172]

JOINT RESOLUTION

Extending the duration of copyright protection in certain cases.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution, or the term thereof as extended by Public Law 87-668, by Public Law 89-

142, or by Public Law 90-141 (or by all or certain of said laws), would expire prior to December 31, 1969, such term is hereby continued until December 31, 1969.

Approved July 23, 1968.

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83 Stat. 360
Public Law 91-147
December 16, 1969
[S. J. Res. 143]

JOINT RESOLUTION

Extending the duration of copyright protection in certain cases.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution, or the term thereof as extended by Public Law 87-668, by Public Law 89-142, by Public Law 90-141, or by Public Law 90-416 (or by all or certain of said laws), would expire prior to December 31, 1970, such term is hereby continued until December 31, 1970.

Approved December 16, 1969.

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85 Stat. 490
Public Law 92-170
November 24, 1971
[S. J. Res. 132]

JOINT RESOLUTION

Extending the duration of copyright protection in certain cases.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any

case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution, or the term thereof as extended by Public Law 87-668, by Public Law 89-142, by Public Law 90-141, by Public Law 90-416, by Public Law 91-147, or by Public Law 91-555 (or by all or certain of said laws), would expire prior to December 31, 1972, such term is hereby continued until December 31, 1972.

Approved November 24, 1971.

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86 Stat. 1181
Public Law 92-566
October 25, 1972
[S. J. Res. 247]

JOINT RESOLUTION

Extending the duration of copyright protection in certain cases.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution, or the term thereof as extended by Public Law 87-668, by Public Law 89-142, by Public Law 90-141, by Public Law 90-416, by Public Law 91-147, by Public Law 91-555, or by Public Law 92-170 (or by all or certain said laws), would expire prior to December 31, 1974, such term is hereby continued until December 31, 1974.

Approved October 25, 1972

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84 Stat. 1141
Public Law 91-555
December 17, 1970
[S.J. Res. 230]

JOINT RESOLUTION

Extending the duration of copyright protection in certain cases.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution, or the term thereof as extended by Public Law 87-668, by Public Law 89-442, by Public Law 90-141, by Public Law 90-416, or by Public Law 91-147 (or by all or certain of said laws), would expire prior to December 31, 1971, such term is hereby continued until December 31, 1971.

Approved December 17, 1970.

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88 Stat. 1873 1873
Public Law 93-573
December 31, 1974

An Act to amend Title 17 of the United States Code to remove the expiration date for a limited copyright in sound recordings, to increase the criminal penalties for piracy and counterfeiting of sound recordings, to extend the duration of copyright protection in certain cases, to establish a national commission on new technological uses of copyrighted works, and for other purposes.

TITLE I—AMEND TITLE 17 UNITED STATES CODE, AND FOR OTHER PURPOSES

* * *

SEC. 104. In any case in which the renewal term of copyright subsisting in any work on the date of approval of this Bill, or the term thereof as extended by Public Law 87-668, by Public Law 89-142, by Public Law 90-141, by Public Law 90-416, by Public Law 91-147, by Public Law 91-555, by Public Law 92-170, or by Public Law 92-566 (17 USC 24 Note) (or by all or certain of said laws), would expire prior to December 31, 1976, such term is hereby continued until December 31, 1976.

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90 Stat. 2541 2541
Public Law 94-553
October 19, 1976

An Act for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes.

* * *

Chapter 3.—DURATION OF COPYRIGHT

Sec. 302. (17 USC 302.) Duration of copyright: Works created on or after January 1, 1978

(a) In General.—Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and fifty years after the author's death.

(b) Joint Works.—In the case of a joint work prepared by two or more authors who did not work for hire, the copyright endures for a term consisting of the life of the last surviving author and fifty years after such last surviving author's death.

(c) Anonymous Works, Pseudonymous Works, and Works Made for Hire.—In the case of an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of seventy-five years from the year of its first publication, or a term of one hundred years from the year of its creation, whichever expires first. If, before the end of such term, the identity of one or more of the authors of an anonymous or pseudonymous work is revealed in the records of a registration made for that work under subsections (a) or (d) of section 408, or in the records provided by this subsection, the copyright in the work endures for the term specified by subsection (a) or (b), based on the life of the author or authors whose identity has been revealed. Any

person having an interest in the copy right in any anonymous or pseudonymous work may at any time record, in records to be maintained by the Copyright Office for that purpose, a statement identifying one or more authors of the work; the statement shall also identify the person filing it, the nature of that person's interest, the source of the information recorded, and the particular work affected, and shall comply in form and content with requirements that the Register of Copyrights shall prescribe by regulation.

Sec. 303. (17 USC 303.) Duration of copyright: Works created but not published or copyrighted before January 1, 1978

Copyright in a work created before January 1, 1978, but not theretofore in the public domain or copyrighted, subsists from January 1, 1978, and endures for the term provided by section 302. In no case, however, shall the term of copyright in such a work expire before December 31, 2002; and, if the work is published on or before December 31, 2002, the term of copyright shall not expire before December 31, 2027.

Sec. 304. (17 USC 304.) Duration of copyright: Subsisting copyrights

(a) Copyrights in Their First Term on January 1, 1978.—Any copyright, the first term of which is subsisting on January 1, 1978, shall endure for twenty-eight years from the date it was originally secured: Provided, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of forty-seven years when application for such renewal and extension shall have been made to the copyright Office and duly registered therein within one year

prior to the expiration of the original term of copyright: And provided further, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his or her next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of forty-seven years when application for such renewal and extension shall have been made to the Copyright Office and duly registered therein within one year prior to the expiration of the original term of copyright: And provided further, That in default of the registration of such application for renewal and extension, the copyright in any work shall terminate at the expiration of twenty-eight years from the date copyright was originally secured.

(b) Copyrights in Their Renewal Term or Registered for Renewal Before January 1, 1978.—The duration of any copyright, the renewal term of which is subsisting at any time between December 31, 1976, and December 31, 1977, inclusive, or for which renewal registration is made between December 31, 1976, and December 31, 1977, inclusive, is extended to endure for a term of seventy-five years from the date copyright was originally secured. (c) Termination of Transfers and Licenses Covering Extended Renewal Term.—In the case of any copyright subsisting in either its first or renewal term on January 1, 1978, other than a copyright in a work made for hire, the exclusive or nonexclusive grant of a transfer or license of the renewal copyright or any right under it, executed before January 1, 1978, by any of the persons designated by the second proviso of subsection (a) of this section, otherwise than by will, is subject to termination under the following conditions:

(1) In the case of a grant executed by a person or persons other than the author, termination of the grant may be effected by the surviving person or persons who expected it. In the case of a grant executed by one or more of the authors of the work, termination of the grant may be effected, to the extent of a particular author's share in the ownership of the renewal copyright, by the author who executed it or, if such author is dead, by the person or persons who, under clause (2) of this subsection, own and are entitled to exercise a total of more than one-half of that author's termination interest.

(2) Where an author is dead, his or her termination interest is owned, and may be exercised, by his widow or her widower and his or her children or grand children as follows:

(A) the widow or widower owns the author's entire termination interest unless there are any surviving children or grandchildren of the author, in which case the widow or widower owns one-half of the author's interest;

(B) the author's surviving children, and the surviving children of any dead child of the author, own the author's entire termination interest unless there is a widow or widower, in which case the the ownership of one-half of the author's interest is divided among them;

(C) the rights of the author's children and grandchildren are in all cases divided among them and exercised on a per stirpes basis according to the number of such author's children represented; the share of the children of a dead child in a termination interest can be exercised only by the action of a majority of them

(3) Termination of the grant may be effected at any time during a period of five years beginning at the end of fifty-six years from the date copyright was originally secured, or beginning on January 1, 1978, whichever is later.

(4) The termination shall be effected by serving an advance notice in writing upon the grantee or the grantee's successor in title. In the case of a grant executed by a person or persons other than the author, the notice shall be signed by all of those entitled to terminate the grant under clause (1) of this subsection, or by their duly authorized agents. In the case of a grant executed by one or more of the authors of the work, the notice as to any one author's share shall be signed by that author or his or her duly authorized agent or, if that author is dead, by the number and proportion of the owners of his or her termination interest required under clauses (1) and (2) of this subsection, or by their duly authorized agents.

(A) The notice shall state the effective date of the termination, which shall fall within the five-year period specified by clause (3) of this subsection, and the notice shall be served not less than two or more than ten years before that date. A copy of the notice shall be recorded in the Copyright Office before the effective date of termination, as a condition to its taking effect.

(B) The notice shall comply, in form, content, and manner of service, with requirements that the Register of Copyrights shall prescribe by regulation.

(5) Termination of the grant may be effected notwithstanding any agreement to the contrary, including an agreement to make a will or to make any future grant.

(6) In case of a grant executed by a person or persons other than the author, all rights under this title that were covered by the terminated grant revert, upon the effective date of termination, to all of those entitled to terminate the grant under clause (1) of this subsection. In the case of a grant executed by one or more of the authors of the work, all of a particular author's rights under this title that were covered by the terminated grant revert, upon the effective date of termination, to that author or, if that author is dead, to the persons owning

his or her termination interest under clause (2) of this subsection, including those owners who did not join in signing the notice of termination under clause (4) of this subsection. In all cases the reversion of rights is subject to the following limitations:

(A) A derivative work prepared under authority of the grant before its termination may continue to be utilized under the terms of the grant after its termination, but this privilege does not extend to the preparation after the termination of other derivative works based upon the copyrighted work covered by the terminated grant.

(B) The future rights that will revert upon termination of the grant become vested on the date the notice of termination has been served as provided by clause (4) of this subsection.

(C) Where the author's rights revert to two or more persons under clause (2) of this subsection, they shall vest in those persons in the proportionate shares provided by that clause. In such a case, and subject to the provisions of subclause (D) of this clause, a further grant, or agreement to make a further grant, of a particular author's share with respect to any right covered by a terminated grant is valid only if it is signed by the same number and proportion of the owners, in whom the right has vested under this clause, as are required to terminate the grant under clause (2) of this subsection. Such further grant or agreement is effective with respect to all of the persons in whom the right it covers has vested under this subclause, including those who did not join in signing it. If any person dies after rights under a terminated grant have vested in him or her, that person's legal representatives, legatees, or heirs at law represent him or her for purposes of this subclause.

(D) A further grant, or agreement to make a further grant, of any right covered by a terminated grant is valid only if it is made after the effective date of the termination. As an exception, however, an agreement for such a further grant may

be made between the author or any of the persons provided by the first sentence of clause (6) of this subsection, or between the persons provided by subclause (C) of this clause, and the original grantee or such grantee's successor in title, after the notice of termination has been served as provided by clause (4) of this subsection.

(E) Termination of a grant under this subsection affects only those rights covered by the grant that arise under this title, and in no way affects rights arising under any other Federal, State, or foreign laws.

(F) Unless and until termination is effected under this subsection, the grant, if it does not provide otherwise, continues in effect for the remainder of the extended renewal term.

Public Law 105-298
October 27, 1998

COPYRIGHTS—TERM EXTENSION AND MUSIC LICENSING EXEMPTION .

An Act to amend the provisions of title 17, United States Code, with respect to the duration of copyright, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

TITLE I—COPYRIGHT TERM EXTENSION

Sec. 101

SEC. 101. SHORT TITLE.

This title may be referred to as the "Sonny Bono Copyright Term Extension Act".

Sec. 102 DURATION OF COPYRIGHT PROVISIONS.

(a) PREEMPTION WITH RESPECT TO OTHER LAWS.—Section 301(c) of title 17, United States Code, is amended by striking "February 15, 2047" each place it appears and inserting "February 15, 2067".

(b) DURATION OF COPYRIGHT: WORKS CREATED ON OR AFTER JANUARY 1, 1978.— Section 302 of title 17, United States Code, is amended—

(1) in subsection (a) by striking "fifty" and inserting "70";

(2) in subsection (b) by striking "fifty" and inserting "70";

(3) in subsection (c) in the first sentence—

(A) by striking "seventy-five" and inserting "95"; and

(B) by striking "one hundred" and inserting "120"; and

(4) in subsection (e) in the first sentence—

(A) by striking "seventy-five" and inserting "95";

(B) by striking "one hundred" and inserting "120"; and

(C) by striking "fifty" each place it appears and inserting "70".

(c) DURATION OF COPYRIGHT: WORKS CREATED BUT NOT PUBLISHED OR COPYRIGHTED BEFORE JANUARY 1, 1978.—Section 303 of title 17, United States Code, is amended in the second sentence by striking "December 31, 2027" and inserting "December 31, 2047".

(d) DURATION OF COPYRIGHT: SUBSISTING COPYRIGHTS.—

(1) IN GENERAL.—Section 304 of title 17, United States Code, is amended—

(A) in subsection (a)—

(i) in paragraph (1)—

(I) in subparagraph (B) by striking "47" and inserting "67"; and

(II) in subparagraph (C) by striking "47" and inserting "67";

(ii) in paragraph (2)—

(I) in subparagraph (A) by striking "47" and inserting "67"; and

(II) in subparagraph (B) by striking "47" and inserting "67"; and

(iii) in paragraph (3)—

(I) in subparagraph (A)(i) by striking "47" and inserting "67"; and

(II) in subparagraph (B) by striking "47" and inserting "67";

(B) by amending subsection (b) to read as follows:

"(b) COPYRIGHTS IN THEIR RENEWAL TERM AT THE TIME OF THE EFFECTIVE DATE OF THE SONNY BONO COPYRIGHT TERM EXTENSION ACT.—Any copyright still in its renewal term at the time that the Sonny Bono Copyright Term Extension Act becomes effective shall have a copyright term of 95 years from the date copyright was originally secured.";

(C) in subsection (c)(4)(A) in the first sentence by inserting "or, in the case of a termination under subsection (d), within the five-year period specified by subsection (d)(2)," after "specified by clause (3) of this subsection,"; and

(D) by adding at the end the following new subsection:

"(d) TERMINATION RIGHTS PROVIDED IN SUBSECTION (c) WHICH HAVE EXPIRED ON OR BEFORE THE EFFECTIVE DATE OF THE SONNY BONO COPYRIGHT TERM EXTENSION ACT.—In the case of any

copyright other than a work made for hire, subsisting in its renewal term on the effective date of the Sonny Bono Copyright Term Extension Act for which the termination right provided in subsection (c) has expired by such date, where the author or owner of the termination right has not previously exercised such termination right, the exclusive or nonexclusive grant of a transfer or license of the renewal copyright or any right under it, executed before January 1, 1978, by any of the persons designated in subsection (a)(1)(C) of this section, other than by will, is subject to termination under the following conditions:

"(1) The conditions specified in subsections (c)(1), (2), (4), (5), and (6) of this section apply to terminations of the last 20 years of copyright term as provided by the amendments made by the Sonny Bono Copyright Term Extension Act.

"(2) Termination of the grant may be effected at any time during a period of 5 years beginning at the end of 75 years from the date copyright was originally secured.".

(2) COPYRIGHT AMENDMENTS ACT OF 1992.—Section 102 of the Copyright Amendments Act of 1992 (Public Law 102-307; 106 Stat. 266; 17 U.S.C. 304 note) is amended—

(A) in subsection (c)—

(i) by striking "47" and inserting "67";

(ii) by striking "(as amended by subsection (a) of this section)"; and

(iii) by striking "effective date of this section" each place it appears and inserting "effective date of the Sonny Bono Copyright Term Extension Act"; and

(B) in subsection (g)(2) in the second sentence by inserting before the period the following: ", except each reference to

forty-seven years in such provisions shall be deemed to be 67 years".

Sec. 103 TERMINATION OF TRANSFERS AND LICENSES COVERING EXTENDED RENEWAL TERM.

Sections 203(a)(2) and 304(c)(2) of title 17, United States Code, are each amended—

(1) by striking "by his widow or her widower and his or her children or grandchildren"; and

(2) by inserting after subparagraph (C) the following:

"(D) In the event that the author's widow or widower, children, and grandchildren are not living, the author's executor, administrator, personal representative, or trustee shall own the author's entire termination interest.".

Sec. 104 REPRODUCTION BY LIBRARIES AND ARCHIVES.

Section 108 of title 17, United States Code, is amended—

(1) by redesignating subsection (h) as subsection (i); and

(2) by inserting after subsection (g) the following:

"(h)(1) For purposes of this section, during the last 20 years of any term of copyright of a published work, a library or archives, including a nonprofit educational institution that functions as such, may reproduce, distribute, display, or perform in facsimile or digital form a copy or phonorecord of such work, or portions thereof, for purposes of preservation, scholarship, or research, if such library or archives has first determined, on the basis of a reasonable investigation, that none of the conditions set forth in subparagraphs (A), (B), and (C) of paragraph (2) apply.

"(2) No reproduction, distribution, display, or performance is authorized under this subsection if—

"(A) the work is subject to normal commercial exploitation;

"(B) a copy or phonorecord of the work can be obtained at a reasonable price; or

"(C) the copyright owner or its agent provides notice pursuant to regulations promulgated by the Register of Copyrights that either of the conditions set forth in subparagraphs (A) and (B) applies.

"(3) The exemption provided in this subsection does not apply to any subsequent uses by users other than such library or archives.".

Sec. 105 VOLUNTARY NEGOTIATION REGARDING DIVISION OF ROYALTIES.

It is the sense of the Congress that copyright owners of audiovisual works for which the term of copyright protection is extended by the amendments made by this title, and the screenwriters, directors, and performers of those audiovisual works, should negotiate in good faith in an effort to reach a voluntary agreement or voluntary agreements with respect to the establishment of a fund or other mechanism for the amount of remuneration to be divided among the parties for the exploitation of those audiovisual works.

Sec. 106 EFFECTIVE DATE.

This title and the amendments made by this title shall take effect on the date of the enactment of this Act.

TITLE II—MUSIC LICENSING EXEMPTION FOR FOOD SERVICE OR DRINKING ESTABLISHMENTS

Sec. 201 SHORT TITLE.

This title may be cited as the "Fairness In Music Licensing Act of 1998".

Sec. 202 EXEMPTIONS.

(a) EXEMPTIONS FOR CERTAIN ESTABLISHMENTS.—Section 110 of title 17, United States Code, is amended—

(1) in paragraph (5)—

(A) by striking "(5)" and inserting "(5)(A) except as provided in subparagraph (B),"; and

(B) by adding at the end the following:

"(B) communication by an establishment of a transmission or retransmission embodying a performance or display of a nondramatic musical work intended to be received by the general public, originated by a radio or television broadcast station licensed as such by the Federal Communications Commission, or, if an audiovisual transmission, by a cable system or satellite carrier, if—

"(i) in the case of an establishment other than a food service or drinking establishment, either the establishment in which the communication occurs has less than 2,000 gross square feet of space (excluding space used for customer parking and for no other purpose), or the establishment in which the communication occurs has 2,000 or more gross square feet of space (excluding space used for customer parking and for no other purpose) and—

"(I) if the performance is by audio means only, the performance is communicated by means of a total of not more than 6 loudspeakers, of which not more than 4 loudspeakers are located in any 1 room or adjoining outdoor space; or

"(II) if the performance or display is by audiovisual means, any visual portion of the performance or display is communicated by means of a total of not more than 4 audiovisual devices, of which not more than 1 audiovisual device is located in any 1 room, and no such audiovisual device

has a diagonal screen size greater than 55 inches, and any audio portion of the performance or display is communicated by means of a total of not more than 6 loudspeakers, of which not more than 4 loudspeakers are located in any 1 room or adjoining outdoor space;

"(ii) in the case of a food service or drinking establishment, either the establishment in which the communication occurs has less than 3,750 gross square feet of space (excluding space used for customer parking and for no other purpose), or the establishment in which the communication occurs has 3,750 gross square feet of space or more (excluding space used for customer parking and for no other purpose) and—

"(I) if the performance is by audio means only, the performance is communicated by means of a total of not more than 6 loudspeakers, of which not more than 4 loudspeakers are located in any 1 room or adjoining outdoor space; or

"(II) if the performance or display is by audiovisual means, any visual portion of the performance or display is communicated by means of a total of not more than 4 audiovisual devices, of which not more than one audiovisual device is located in any 1 room, and no such audiovisual device has a diagonal screen size greater than 55 inches, and any audio portion of the performance or display is communicated by means of a total of not more than 6 loudspeakers, of which not more than 4 loudspeakers are located in any 1 room or adjoining outdoor space;

"(iii) no direct charge is made to see or hear the transmission or retransmission;

"(iv) the transmission or retransmission is not further transmitted beyond the establishment where it is received; and

"(v) the transmission or retransmission is licensed by the copyright owner of the work so publicly performed or displayed;"; and

(2) by adding after paragraph (10) the following:

"The exemptions provided under paragraph (5) shall not be taken into account in any administrative, judicial, or other governmental proceeding to set or adjust the royalties payable to copyright owners for the public performance or display of their works. Royalties payable to copyright owners for any public performance or display of their works other than such performances or displays as are exempted under paragraph (5) shall not be diminished in any respect as a result of such exemption.".

(b) EXEMPTION RELATING TO PROMOTION.—Section 110(7) of title 17, United States Code, is amended by inserting "or of the audiovisual or other devices utilized in such performance," after "phonorecords of the work,".

Sec. 203 LICENSING BY PERFORMING RIGHTS SOCIETIES.

(a) IN GENERAL.—Chapter 5 of title 17, United States Code, is amended by adding at the end the following:

"s 512. Determination of reasonable license fees for individual proprietors

"In the case of any performing rights society subject to a consent decree which provides for the determination of reasonable license rates or fees to be charged by the performing rights society, notwithstanding the provisions of that consent decree, an individual proprietor who owns or operates fewer than 7 non-publicly traded establishments in which nondramatic musical works are performed publicly and who claims that any license agreement offered by that performing rights society is unreasonable in its license rate or fee as to that individual proprietor, shall be entitled to determination of a reasonable license rate or fee as follows:

"(1) The individual proprietor may commence such proceeding for determination of a reasonable license rate or fee by filing an application in the applicable district court under paragraph (2) that a rate disagreement exists and by serving a copy of the application on the performing rights society. Such proceeding shall commence in the applicable district court within 90 days after the service of such copy, except that such 90-day requirement shall be subject to the administrative requirements of the court.

"(2) The proceeding under paragraph (1) shall be held, at the individual proprietor's election, in the judicial district of the district court with jurisdiction over the applicable consent decree or in that place of holding court of a district court that is the seat of the Federal circuit (other than the Court of Appeals for the Federal Circuit) in which the proprietor's establishment is located.

"(3) Such proceeding shall be held before the judge of the court with jurisdiction over the consent decree governing the performing rights society. At the discretion of the court, the proceeding shall be held before a special master or magistrate judge appointed by such judge. Should that consent decree provide for the appointment of an advisor or advisors to the court for any purpose, any such advisor shall be the special master so named by the court.

"(4) In any such proceeding, the industry rate shall be presumed to have been reasonable at the time it was agreed to or determined by the court. Such presumption shall in no way affect a determination of whether the rate is being correctly applied to the individual proprietor.

"(5) Pending the completion of such proceeding, the individual proprietor shall have the right to perform publicly the copyrighted musical compositions in the repertoire of the performing rights society by paying an interim license rate or fee into an interest bearing escrow account with the clerk of

the court, subject to retroactive adjustment when a final rate or fee has been determined, in an amount equal to the industry rate, or, in the absence of an industry rate, the amount of the most recent license rate or fee agreed to by the parties.

"(6) Any decision rendered in such proceeding by a special master or magistrate judge named under paragraph (3) shall be reviewed by the judge of the court with jurisdiction over the consent decree governing the performing rights society. Such proceeding, including such review, shall be concluded within 6 months after its commencement.

"(7) Any such final determination shall be binding only as to the individual proprietor commencing the proceeding, and shall not be applicable to any other proprietor or any other performing rights society, and the performing rights society shall be relieved of any obligation of nondiscrimination among similarly situated music users that may be imposed by the consent decree governing its operations.

"(8) An individual proprietor may not bring more than one proceeding provided for in this section for the determination of a reasonable license rate or fee under any license agreement with respect to any one performing rights society.

"(9) For purposes of this section, the term 'industry rate' means the license fee a performing rights society has agreed to with, or which has been determined by the court for, a significant segment of the music user industry to which the individual proprietor belongs.".

(b) TECHNICAL AND CONFORMING AMENDMENT.—The table of sections for chapter 5 of title 17, United States Code, is amended by adding after the item relating to section 511 the following:

"512. Determination of reasonable license fees for individual proprietors.".

Sec. 204 PENALTIES.

Section 504 of title 17, United States Code, is amended by adding at the end the following:

"(d) ADDITIONAL DAMAGES IN CERTAIN CASES.—In any case in which the court finds that a defendant proprietor of an establishment who claims as a defense that its activities were exempt under section 110(5) did not have reasonable grounds to believe that its use of a copyrighted work was exempt under such section, the plaintiff shall be entitled to, in addition to any award of damages under this section, an additional award of two times the amount of the license fee that the proprietor of the establishment concerned should have paid the plaintiff for such use during the preceding period of up to 3 years.".

Sec. 205 DEFINITIONS.

Section 101 of title 17, United States Code, is amended—

(1) by inserting after the definition of "display" the following:

"An 'establishment' is a store, shop, or any similar place of business open to the general public for the primary purpose of selling goods or services in which the majority of the gross square feet of space that is nonresidential is used for that purpose, and in which nondramatic musical works are performed publicly.

"A 'food service or drinking establishment' is a restaurant, inn, bar, tavern, or any other similar place of business in which the public or patrons assemble for the primary purpose of being served food or drink, in which the majority of the gross square feet of space that is nonresidential is used for that purpose, and in which nondramatic musical works are performed publicly.";

(2) by inserting after the definition of "fixed" the following:

"The 'gross square feet of space' of an establishment means the entire interior space of that establishment, and any adjoining outdoor space used to serve patrons, whether on a seasonal basis or otherwise.";

(3) by inserting after the definition of "perform" the following:

"A 'performing rights society' is an association, corporation, or other entity that licenses the public performance of nondramatic musical works on behalf of copyright owners of such works, such as the American Society of Composers, Authors and Publishers (ASCAP), Broadcast Music, Inc. (BMI), and SESAC, Inc."; and

(4) by inserting after the definition of "pictorial, graphic and sculptural works" the following:

"A 'proprietor' is an individual, corporation, partnership, or other entity, as the case may be, that owns an establishment or a food service or drinking establishment, except that no owner or operator of a radio or television station licensed by the Federal Communications Commission, cable system or satellite carrier, cable or satellite carrier service or programmer, provider of online services or network access or the operator of facilities therefor, telecommunications company, or any other such audio or audiovisual service or programmer now known or as may be developed in the future, commercial subscription music service, or owner or operator of any other transmission service, shall under any circumstances be deemed to be a proprietor.".

Sec. 206 CONSTRUCTION OF TITLE.

Except as otherwise provided in this title, nothing in this title shall be construed to relieve any performing rights society of any obligation under any State or local statute, ordinance, or law, or consent decree or other court order governing its operation, as such statute, ordinance, law, decree, or order is

in effect on the date of the enactment of this Act, as it may be amended after such date, or as it may be issued or agreed to after such date.

Sec. 207 EFFECTIVE DATE.

This title and the amendments made by this title shall take effect 90 days after the date of the enactment of this Act.

Approved October 27, 1998.